

# Fordham Intellectual Property, Media and Entertainment Law Journal

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Volume 6 *Volume VI*  
Number 1 *Volume VI Book 1*

Article 2

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1995

## It Had to be Hue: The Meaning of Color “Pure and Simple”

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### Recommended Citation

Karin S. Schwartz, *It Had to be Hue: The Meaning of Color “Pure and Simple”*, 6 Fordham Intell. Prop. Media & Ent. L.J. 59 (1995).  
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### Cover Page Footnote

Fred A. Bernstein, Nancy J. Mertz, Yvonne K. Ruben and Judge Jack B. Weinstein provided invaluable comments, suggestions and encouragement, for which I am deeply grateful. I also appreciate the insights and editing skills of the editors at the Fordham Intellectual Property, Media & Entertainment Law Journal.

# It Had to be Hue: The Meaning of Color "Pure and Simple"

Karin S. Schwartz\*

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## INTRODUCTION

In *Qualitex Co. v. Jacobson Products Co.*<sup>1</sup> the Supreme Court confronted the question of whether a trademark consisting "purely and simply, of a color" can be registered as a trademark under the Lanham Act.<sup>2</sup> The Court answered the question with an unequivocal and unanimous "yes," leaving intact the Petitioner's trademark registration of the "green-gold" color for its press pads sold to commercial dry cleaners.<sup>3</sup> The alternative would have been to protect color only indirectly, as an element of an overall design.<sup>4</sup>

In its decision to protect color "pure and simple," the Court accepted a false dichotomy: that its options were only the two alternatives presented to it by the parties and the preexisting case law. The court also accepted a false premise: that it is possible for a mark to consist only of color. All trademarks, including color marks, are composites of several elements.<sup>5</sup> The actual question

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1. 115 S. Ct. 1300 (1995).

2. See *id.* at 1302 ("purely and simply, of a color"); *id.* at 1308 ("color, pure and simple"); 15 U.S.C. §§ 1051-1127 (1994) (Lanham Act).

3. See *Qualitex*, 115 S. Ct. at 1302, 1308.

4. See *infra* note 17; see also *infra* notes 76-86 and accompanying text.

5. In theory, there may be a potentially infinite number of "elements" in any mark. Consider texture and variations within it, external lighting, atomic structure and other factors. While description of *all* the elements comprising a trademark may be impossible, it is also not necessary. Cf. *infra* notes 46-47 and accompanying text. This Article suggests, however, that trademark analysis should take as a starting point the composite nature of all marks, and that it should be at least cognizant of some of the latent elements that are often overlooked.

implicated in *Qualitex* and similar cases is not whether mere color should be deemed registrable, but whether a trademark can consist of color alone.<sup>6</sup>

The issue raised in *Qualitex* is not merely a quibble over semantics. The traditional arguments against protecting colors as trademarks, specifically, the color depletion, shade confusion and functionality theories,<sup>7</sup> only make sense if one accepts the fiction that color "pure and simple" is a possibility. If the inherent composite nature of all marks is considered, these objections generally subside.<sup>8</sup>

In failing to recognize the composite nature of trademarks, including color trademarks, the Court may have violated the "Anti-Dissection" rule, a cardinal rule of trademark law. This rule provides that "[t]he commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail."<sup>9</sup> A mark's individual components may be considered as a preliminary step in determining its overall impression.<sup>10</sup> However, trademark law will not pick and choose particular elements to protect; instead, it considers the mark as a whole.<sup>11</sup> By failing to identify more accurately the composite nature of the trademark at issue, and by protecting the "color" element to the exclusion of all else, the Court violated this rule.

Despite *Qualitex*'s shortcomings, applying traditional tests for infringement may correct problems in its analysis.<sup>12</sup> Moreover, *Qualitex*'s holding does not preclude courts from engaging, as appropriate, in the accurate identification of latent elements. Such an analysis may be useful in explaining apparent anomalies existing in trademark doctrine, such as the courts' historical reluctance to

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6. See discussion *infra* part I.C.

7. See *infra* notes 26-36, 87-91 and accompanying text (discussing these arguments).

8. See *infra* notes 87-91 and accompanying text.

9. *Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545-46 (1920). See generally *infra* notes 50-56 and accompanying text.

10. See *infra* note 56 and accompanying text.

11. See *infra* notes 54-55 and accompanying text. An exception may be the functionality doctrine. See *infra* note 56.

12. See *infra* part I.F.

confer trademark protection on the color of liquids.<sup>13</sup> It may also draw some litigation away from abstract and hypothetical considerations of trademarkability and focus them instead on the substantive issues: whether the plaintiff's mark has acquired secondary meaning, if the mark is not inherently distinctive, and whether the two marks at issue are confusingly similar.<sup>14</sup>

The Court's approach in *Qualitex* may reflect systematic underdescription of trademarks by the courts and by parties. As described in this Article, mark proponents may sometimes underdescribe their own marks to overemphasize similarities with the purportedly infringing marks of their competitors. At the same time, underdescribing a mark may hurt a mark proponent where a competitor argues, and the court accepts, that the mark is too basic to receive protection.

This Article analyzes *Qualitex*, and its consequences for protecting so-called color marks from the premise that all marks, including color marks, are unavoidably composite in nature. Part I reviews the Court's analysis and holding in *Qualitex*, and identifies the actual question implicated in the mere color trademark cases. Part I also discusses the inherent composite nature of all marks and the ability of existing trademark doctrine to absorb that recognition without difficulty. Finally, Part I analyzes whether *Qualitex* violates the Anti-Dissection Rule. Part II examines why the question in *Qualitex* was so narrowly posed to the Court. Part II also demonstrates that the traditional objections to trademark protection, including the color depletion and shade confusion arguments, are negated by the recognition that all marks are composites. Part III addresses the protection of "color marks" after *Qualitex*. This part first discusses the importance of properly describing the entirety of the mark for which protection is sought, and the pitfalls that may accompany underdescription. Part III then discusses possible applications of the type of trademark component identification discussed here after *Qualitex*. It continues with an analysis of the special problems presented by protection of colors in liquids. Next, Part

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13. See *infra* part III.C.

14. See *infra* Conclusion.

III discusses whether "color marks" can be inherently distinctive, and therefore able to receive trademark protection before secondary meaning has been demonstrated. This issue, not addressed by the Court, is answered here in the affirmative. Finally, Part III reviews a recent Second Circuit Court of Appeals case which appears to conflict with *Qualitex*, and which may perpetuate some of the systemic problems in trademark law here described.

This Article concludes by identifying a possible practical consequence of adopting latent element identification, a consequence that may transcend color marks. Accurate identification and recognition of the many elements involved in trademarks can potentially draw the courts away from an abstract and hypothetical analysis of "trademarkability," and focus litigation instead on the substantive infringement issues presented by plaintiffs' and defendants' marks.

## I. THE QUESTION POSED (AND ANSWERED) IN *QUALITEX*

### A. *The Question Posed: Can Color Function as a Trademark?*

In the Court's view, the question presented was "whether the . . . Trademark Act of 1946 permits the registration of a trademark that consists, purely and simply, of a color."<sup>15</sup> As phrased in the Petitioner's and Respondent's briefs, the question presented was "[w]hether the Lanham Act prohibits the registration of color as a trademark."<sup>16</sup> The alternative to protecting color "purely and simply," at least in the eyes of the parties and the Court, was to protect it as an "element" of a trademark, in combination with other design elements.<sup>17</sup> Prior to *Qualitex*, it was generally accepted that

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15. *Qualitex*, 115 S. Ct. at 1302 (citation omitted). *Qualitex* registered its green-gold color for pressmarks in 1991, during its dispute with Jacobson Products. See *id.*

16. Petitioner's Brief on the Merits at i, *Qualitex Co. v. Jacobson Prods. Co.*, 115 S. Ct. 1300 (1995) (No. 93-1577) [hereinafter Petitioner's Brief]; Brief for the Respondent at i, *Qualitex* (No. 93-1577) [hereinafter Respondent's Brief].

17. See *Qualitex*, 115 S. Ct. at 1308 (considering Respondent's argument that protection of colors is not needed since "a firm already may use color as part of a trademark"); see also Oral Argument at 36, *Qualitex* (No. 93-1577) [hereinafter Oral Argument] ("QUESTION: But everyone agrees, I take it, that color can be part of a registerable device or symbol . . . [Respondent]: Everyone—even I agree with that."); Respondent's Brief at 1-2 ("Rather than seeking to protect color as part of a design, symbol, device,

“the Lanham Act already provides substantial protection for color, both as an element of device, design, symbol or logo, or when functioning as trade dress.”<sup>18</sup>

### B. *The Court's Answer*

The Court answered affirmatively, that color “pure and simple” can comprise a registrable trademark. In a unanimous opinion, the Court held that “color may sometimes meet the basic legal requirements for use as a trademark and that respondent[’s] arguments do not justify a special legal rule preventing color alone from serving as a trademark.”<sup>19</sup> The Court concluded that since the Petitioner had demonstrated that its mark had “secondary meaning” and therefore identifies and distinguishes its press pads from its competitors’, Qualitex’s trademark use of the green-gold color should be protected.<sup>20</sup>

The Court construed the Lanham Act as describing the “universe of things that can qualify as a trademark . . . in the broadest of terms.”<sup>21</sup> It noted that both of the two substantive elements in the Lanham Act’s definition of trademarks were present in Qualitex’s green-gold mark. First, reasoning that “human beings might use as a ‘symbol’ or ‘device’ almost anything at all that is capable of carrying meaning,”<sup>22</sup> the Court held that colors could be encompassed within the Lanham Act’s definition of “trademark” to “‘includ[e] any word, name, symbol, or device, or any combination thereof.’”<sup>23</sup> Second, the Court found that the requirement that the

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logo or brand name . . . , Petitioner seeks an unwarranted, unnecessary and anti-competitive extension of the Lanham Act . . . .”; *id.* at 8 (“[T]he Lanham Act already provides substantial protection for color, both as an element of device, design, symbol or logo, or when functioning as trade dress.”); *id.* at 9 (“Color is protectable under the Lanham Act when color is included as an element of a trademark.”); Petitioner’s Reply Brief at 12, *Qualitex* (No. 93-1577) [hereinafter “Petitioner’s Reply Brief”] (rebutting argument that Lanham Act provides “adequate alternative protection for unregistered color”); *infra* notes 83-86 and accompanying text.

18. Respondent’s Brief at 8. See generally *infra* notes 76-86 and accompanying text.

19. *Qualitex*, 115 S. Ct. at 1308.

20. *Id.* at 1305, 1308.

21. *Id.* at 1302.

22. *Id.* at 1302-03.

23. *Id.* at 1302 (quoting 15 U.S.C. § 1127).



proposed mark be used "to identify and distinguish [the registrant's] goods . . . from those manufactured or sold by others and to indicate the source of the goods" could also be satisfied by a color, at least where it has achieved secondary meaning.<sup>24</sup> The Court explained that "[i]t is the source-distinguishing ability of a mark—not its ontological status as color, shape, fragrance, word, or sign—that permits it to serve these basic purposes."<sup>25</sup>

The Court also considered whether the "functionality" doctrine prevents the registration of color in all instances, and concluded that it does not.<sup>26</sup> The functionality doctrine provides that one may not receive trademark protection for a product's useful features.<sup>27</sup> A feature is considered functional "if it is essential to the use or purpose of the article or if it affects the cost or quality of the article."<sup>28</sup> By preventing manufacturers from putting "competitors at a significant non-reputation-related disadvantage," the functionality doctrine limits trademark law's anticompetitive tendencies.<sup>29</sup> The

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24. *Id.* at 1303 (quoting 15 U.S.C. § 1127). Secondary meaning is the "mental association in buyers' minds between the alleged mark and a single source of the product." 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 15.02[1], at 15-8 (3d ed. 1995) (emphasis added); see also *id.* § 15.02[3], at 15-11 (summarizing "judicial definitions" of secondary meaning). The issue of whether a color can be "inherently distinctive," and therefore be registered without showing secondary meaning, remains open after *Qualitex*, although it was the focus of much of the oral argument before the Court. See *infra* part III.D.

25. *Qualitex*, 115 S. Ct. at 1304.

26. *Id.* at 1304, 1306-07.

27. See e.g. 1 MCCARTHY, *supra* note 24, § 7.26. Protection of functional features is the province of patent law, 35 U.S.C. §§ 101-105 (1988 & Supp. V 1993), which confers relatively robust protection, for a limited time, to "any new and useful process, machine, manufacture, or composition of matter," *id.* § 101, that meets its rigid criteria for protection. See also 35 U.S.C. §§ 171-173 (1988) (design patents).

28. *Inwood Lab., Inc. v. Ives Lab., Inc.*, 456 U.S. 844, 850 n.10 (1982); see also Lee Burgunder, *Trademark Registration of Product Colors: Issues and Answers*, 26 SANTA CLARA L. REV. 581, 609 (1986) ("[A] design is not protectable as a trademark if it enables the product to perform its utilitarian functions in a way that is superior to designs available to competitors." (citing *In re Morton-Norwich Prods. Co.*, 671 F.2d 1332 (C.C.P.A. 1982))); 1 MCCARTHY, *supra* note 24, § 7.26[1], at 7-114 ("If the feature[s] give the product more utility, or contribute to economy of manufacture, the features are 'functional' and are not capable of legal protection.").

29. *Qualitex*, 115 S. Ct. at 1304 (citing *Inwood Labs*); see also Anthony V. Lupo, *The Pink Panther Sings the Blues: Is Color Capable of Trademark Protection?*, 21 MEM.

functionality doctrine is commonly invoked with respect to color marks where there is a concern that protection will confer a competitive advantage because consumers seeking to match new purchases to old purchases will be induced to buy the trademark holder's goods.<sup>30</sup> The Court noted that color is not necessarily functional in every situation, including the case that was before it.<sup>31</sup>

Next, the Court rejected the traditional arguments supporting a per se rule against registration of colors: the "shade confusion"<sup>32</sup> and "color depletion" arguments.<sup>33</sup> In rejecting the shade confusion argument, which questions the courts' competence to distinguish among shades in reaching an infringement determination, the Court rationalized that color does not present "special" problems in rela-

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ST. U. L. REV. 637, 641 (1991) ("[D]e jure functionality exists when the design has utility and is one of the few superior designs because it yields a competitive or economic advantage.").

30. See, e.g., *Deere & Co. v. Farmhand, Inc.*, 560 F. Supp. 85, 96 (S.D. Iowa 1982), *aff'd*, 721 F.2d 253 (8th Cir. 1983); *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 1531 (Fed. Cir. 1994) (color black held functional because of its compatibility with other colors and its ability to decrease apparent motor size), *cert. denied*, 115 S. Ct. 1426 (1995). A particular color has also been held functional because of its "therapeutic effect," as when used on medication, or because of its cost efficiency as when it is the cheapest to apply. See, e.g., *Inwood Labs.*, 456 U.S. at 853 (lower court held color blue on pills functional because of therapeutic effect and use by persons attempting to identify drugs in emergency situations); *Burgunder*, *supra* note 28, at 607 ("A product color also may be supply functional if that color or combination of colors is less expensive to apply to the product than are alternative colors."). *Burgunder* asserts that "[m]ost courts have lost sight of the purpose of the functionality doctrine, and consequently have blended many diverse and often inappropriate concepts into the doctrine." *Id.* at 606.

31. *Qualitex*, 115 S. Ct. at 1304. For examples of cases in which color was found to be functional, see *supra* note 30.

32. In *NutraSweet Co. v. Stadt Corp.*, 917 F.2d 1024, 1027 (7th Cir. 1990), *cert. denied*, 499 U.S. 983 (1991), the court explained its concern that if color per se were to be appropriated as a trademark symbol, "infringement actions could soon degenerate into questions of shade confusion" between closely similar shades. See also *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1131 (Fed. Cir. 1985); *Deere & Co.*, 560 F. Supp. at 97 n.20; 1 MCCARTHY, *supra* note 24, § 7.16[1], at 7-70.

33. The color depletion theory originated in *Diamond Match Co. v. Saginaw Match Co.*, 142 F. 727 (6th Cir.), *cert. denied*, 203 U.S. 589 (1906) (denying protection of blue and red colors used on match tips on principle that given limited number of colors, other manufacturers would monopolize those remaining and the available list of colors would soon run out) and gained currency with *Campbell Soup Co. v. Armour & Co.*, 175 F.2d 795 (3d Cir.), *cert. denied*, 338 U.S. 847 (1949).

tion to the difficult comparisons that courts routinely make in trademark infringement cases.<sup>34</sup> The Court further explained that the color depletion argument, which addresses the anticompetitive effects of permitting an entity to monopolize one color, is implicated only occasionally and therefore does not justify a blanket rule against registrability.<sup>35</sup> Where a problem does arise with respect to a purported color mark, the Court reasoned that the functionality doctrine would apply.<sup>36</sup>

The Court also refuted the continuing applicability<sup>3</sup> of pre-Lanham Act common law holdings that color alone may not be protected. In the Court's view, the liberalization of trademark law through enactment of the Lanham Act, including its extension of registration to "descriptive marks" on a showing of secondary meaning, represented Congressional rejection of the older common law's generally restrictive approach to trademark protection.<sup>37</sup>

Finally, the Court considered the argument that protection of color alone is unnecessary since color may be protected indirectly through its combination with other design elements in an enforceable trademark, or, alternatively, as trade dress under section 43(a) of the Lanham Act.<sup>38</sup> The Court found these arguments unpersuasive, explaining that there may be circumstances in which "a

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34. *Qualitex*, 115 S. Ct. at 1305.

35. *Id.* at 1306 ("This argument is unpersuasive . . . largely because it relies on an occasional problem to justify a blanket prohibition.").

36. *Id.*; see also *Brunswick Corp.*, 35 F.3d at 1532 ("The functionality limitation on trademark protection properly subsumes any lingering policy concerns embodied in the 'color depletion theory.'").

37. *Qualitex*, 115 S. Ct. at 1307-08. The older common law includes the Court's own dictum, in *A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co.*, 201 U.S. 166, 171 (1906), that "[w]hether mere color can constitute a valid trade-mark may admit of doubt." See *infra* text accompanying note 79. The *Qualitex* Court explained that "[t]he Lanham Act significantly changed and liberalized the common law to 'dispense with mere technical prohibitions' . . . most notably, by permitting trademark registration of descriptive words . . . where they had acquired 'secondary meaning.'" *Qualitex*, 115 S. Ct. at 1307 (quoting S. REP. NO. 1333, 79th Cong., 2d Sess. 3 (1946)). This "liberaliz[ing]" trend, in the Court's view, together with some subsequent revision of the Lanham Act, evinced Congressional intent to include protection of colors within the ambit of trademark law.

38. 15 U.S.C. § 1125(a) (1994).

firm might want to use color, pure and simple, instead of color as part of a design."<sup>39</sup> Since the protection available under trademark law is more robust than that conferred on trade dress, the Court noted that "one can easily find reasons why the law might provide trademark protection in addition to trade dress protection."<sup>40</sup>

*C. The Actual Question Implicated: Is it Possible for a Trademark to Consist Only of Color?*

As the issues were framed by the parties, the Supreme Court faced two clear and mutually exclusive alternatives. First, it could permit registration of color "alone," independently of other design elements. Second, it could refuse such registration with the understanding that color would be protected incident to other design elements in an overall configuration for which registration is permitted.<sup>41</sup> In limiting its decision to one of these alternatives, the Court missed an important question: is it possible for a mark to consist of color alone, that is, to be devoid of any other elements? The answer is "no."

*D. Resolving the Actual Legal Problem Posed*

A registrable trademark cannot consist of color alone because color never appears by itself in a mark. Color necessarily appears in every mark designed for visual perception, and it is never a mark's sole component. Color, itself, is a combination of three different elements: hue, saturation and brightness.<sup>42</sup> In addition, these three elements can be applied in a variety of ways. The mark under consideration in *Qualitex*, for example, was not simply "green-gold." It was a solid green-gold that blanketed the entire pad, presumably without any breaks or other designs.<sup>43</sup> At a mini-

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39. *Qualitex*, 115 S. Ct. at 1308.

40. *Id.* The Court noted that trademarks benefit from statutory provisions governing importation of confusingly similar goods, constructive notice of ownership, incontestability, and prima facie evidence of validity and ownership. *Id.*

41. See *supra* text accompanying note 17.

42. Color is defined as "the quality of an object or substance with respect to light reflected by it, usu. determined visually by measurement of hue, saturation, and brightness of the reflected light." RANDOM HOUSE WEBSTER'S COLLEGE DICTIONARY 268 (McGraw Hill ed. 1991).

43. See *Qualitex*, 115 S. Ct. at 1302, 1305, 1308 (describing *Qualitex's* mark);

num, the mark at issue in *Qualitex* had the following seven elements: (1) green-gold hue,<sup>44</sup> (2) specific saturation, (3) specific brightness, (4) solid application, (5) opaque, (6) applied all over (i.e., conforming to the shape of the product), (7) without variation in any of the previous elements.

The second and third elements, saturation and brightness, will not be specifically addressed, as they are subsumed under the broad definition of color.<sup>45</sup> Also, intuitively, ordinary viewers may be less likely to perceive small variations in saturation and brightness in comparison to variation in other mark elements.<sup>46</sup> Therefore, varying saturation and brightness in a mark will rarely, if ever, result in a new, noninfringing mark.<sup>47</sup>

Except as noted, were any one of the elements described above

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Petitioner's Brief at 6 ("For over 30 years, Qualitex has promoted and sold its SUN GLOW [registered] commercial dry cleaning press pad using a fabric cover in a unique green-gold color."); cf. Daniel R. Schechter, Comment, *Qualitex Co. v. Jacobson Prods., Inc.: The Supreme Court "Goes for the Gold" and Allows Trademark Protection for Color Per Se*, 5 FORDHAM INTELL. PROP., MEDIA & ENT. L.J. 481, 482 (1995) ("A color per se trademark is a color used in a uniform, nondistinctive manner, and not in conjunction with any symbol."). In fact, in addition to the green-gold color, all Qualitex pads are imprinted with the "SUN GLOW" mark on the "side or skirt portion of the press-pad cover," raising the possibility that the parties underdescribed the mark at issue. See *Qualitex Co. v. Jacobson Prods. Co.*, 13 F.3d 1297, 1305 (9th Cir. 1994), *rev'd on other grounds*, 115 S. Ct. 1300 (1995); see also *infra* part III.A. (discussing consequences of underdescription); *infra* notes 173-74 and accompanying text (similar).

44. As a practical matter, trademark protection in one hue spreads beyond that particular hue to all other hues that can be considered "confusingly similar." Cf. 1 MC-CARTHY, *supra* note 24, § 7.16[1], at 7-69 to 7-70.

45. See *supra* note 42.

46. For example, viewers might simply interpret variations in "brightness" as a change in exterior lighting conditions rather than in the mark itself.

47. For example, assume manufacturer Y has a trademark in a specific blue hue, of a specific saturation and brightness, applied as an opaque solid all over a product without variation. Manufacturer Z's use of the same hue, applied the same way, on the same product, varying only the brightness and saturation, would probably be found to infringe upon manufacturer Y's trademark. See generally *infra* notes 70-73 and accompanying text (standard test for infringement). Varying merely saturation and brightness is unlikely to create a separate "commercial impression" in consumers' minds, see *infra* notes 53-56 and accompanying text, because consumers may assume such differences arise from changes in exterior lighting or factors relating to the mechanics of a mark's reproduction. Cf. *Qualitex*, 115 S. Ct. at 1305 (noting significance of "lighting conditions" in an infringement determination).

to be subtracted or altered significantly, a new, noninfringing, mark could well result. Suppose, for example, element (4), "solid application," is manipulated. Covering a pad with green-gold stripes over its entire surface, using the exact same shade as the Qualitex pad, would not necessarily cause consumers to think that the product was produced by Qualitex.<sup>48</sup> Nor would they necessarily wrongfully attribute to Qualitex a pad which was partially covered by green-gold, perhaps only at its borders.

In *Qualitex*, the question on which protection of Respondent's mark turned, then, was whether a mark that consists of a solid, designated color blanketed uniformly over some object is registrable. Clearly, the answer is "yes." If a solid, designated color blanketed *nonuniformly* over an object is trademarkable, then, certain other conditions being met, surely a solid application can be trademarked as well. The specific color would probably have to be identified in any event since trademark protection is difficult, though not impossible, to achieve for a distinctive application of an unspecified color.<sup>49</sup>

Approaching the question in this way recognizes that all trademarks are "composites" of positive attributes. Given that "black," "white" and untinted "transparent" (i.e., clear) may be considered colors for trademark purposes,<sup>50</sup> it is impossible to develop a graph-

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48. Non-solid configurations will often involve at least one other color in combination with the "protected color." Stripes, for example, often involve two or more distinct "colors." See RANDOM HOUSE WEBSTER'S COLLEGE DICTIONARY, *supra* note 42, at 1324 (defining "stripe" as "a narrow band differing in color, material or texture from the background parts").

49. See, e.g., *A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co.*, 201 U.S. 166, 170 (1906) ("[T]he description of a colored streak, which would be answered by a streak of any color painted spirally *with* the strand . . . [is] too indefinite to be the subject of a valid trademark."). But see *In re Data Packaging Corp.*, 453 F.2d 1300, 1303 (C.C.P.A. 1972) (mark consisting of annular band on a computer tape reel of contrasting but unspecified colors held "neither indefinite nor unduly broad"); *In re Eagle Fence Rentals, Inc.*, 231 U.S.P.Q. (BNA) 228, 231 (T.T.A.B. 1986) (permitting registration, as service mark, of a contrasting color scheme applied in a "definite pattern" to chain-link fencing, where individual colors to be applied were not specified).

50. See THE COMPACT EDITION OF THE OXFORD ENGLISH DICTIONARY 470 (Oxford Univ. Press. 1971) ("In speaking of the colours of objects, *black* and *white*, in which the rays of light are respectively wholly absorbed and wholly reflected, are included."); *cf.*

ically represented mark that does not contain at least one color. It is likewise impossible to develop a design that does not consist of a shape. In *Qualitex*, for example, the shape of the mark was the contour of the press pad. Thus, any mark designed for visual perception consists of a combination of at least color and shape.<sup>51</sup> Even trademarks that seek to minimize color or shape are composites of positive attributes, as one district court recognized when it held that "simplicity of design itself [can] speak[] of origin."<sup>52</sup>

Although the law recognizes that some trademarks are composites, it is nonetheless, in some sense, indifferent to that fact.<sup>53</sup> In protecting composites, what matters is that the "totality" of the mark is capable of serving the trademark function of identifying

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Campbell Soup Co. v. Armour & Co., 175 F.2d 795, 798 (3d Cir.), *cert. denied*, 338 U.S. 847 (1949) (considering color depletion argument and noting that "[t]he primary colors, even adding black and white, are but few." (quoting *Diamond Match Co. v. Saginaw Match Co.*, 142 F. 727, 729 (6th Cir. 1906))). While it may be harder for black or white to be found protectable, the courts are at least willing to consider the issue. See *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527 (Fed. Cir. 1994) (use of color black on marine outboard motors held *de jure* functional, and therefore not entitled to trademark protection), *cert. denied*, 115 S. Ct. 1426 (1995); *Mana Prods., Inc. v. Columbia Cosmetics Mfg.*, 858 F. Supp. 361, 367 (E.D.N.Y. 1994) (use of color black on rectangular compacts held not sufficiently distinctive to be protectable), *aff'd*, 65 F.3d 1063 (2d Cir. 1995).

Courts have also protected marks distinctive for their use of untinted transparent materials ("clear"), see, e.g., *Essie Cosmetics, Ltd. v. Dae Do Int'l, Ltd.*, 808 F. Supp. 952, 954-55, 957 (E.D.N.Y. 1992), although such materials are frequently deemed functional. See 1 MCCARTHY, *supra* note 24, § 7.28[1], at 7-166 ("The use of ordinary packaging such as transparent cellophane is functional and free for all to use.").

51. Cf. *Stormy Clime Ltd. v. Progroup, Inc.*, 809 F.2d 971, 974 (2d Cir. 1987) ("The trade dress of a product 'involves the total image of a product and may include features such as size, shape, color or color combinations, texture, [or] graphics.'" (quoting *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 980 (11th Cir. 1983))). Although courts are more likely to identify the many elements that comprise trade dress, as compared with their analysis of trademarks, in both cases protection turns on "overall impression." See 1 MCCARTHY, *supra* note 24, § 8.01[1], at 8-2 ("To determine trade dress infringement, the court must consider the *total image or overall impression* of plaintiff's product, package and advertising and compare this with the corresponding image or impression of the defendant's product.") (emphasis added) (footnote omitted).

52. *Essie Cosmetics*, 808 F. Supp. at 955, 957 (enjoining competitor from copying plaintiff's "square clear glass bottle with a simple cylindrical white cap" used to sell nail polish). But see *supra* note 50 (citing 1 MCCARTHY, *supra* note 24, § 7.28[1], at 7-166).

53. See generally 1 MCCARTHY, *supra* note 24, § 11.10.

and distinguishing the goods on which it is affixed.<sup>54</sup> This follows from the rule that applies to all trademarks, whether explicitly recognized as composite or not, that "[t]he commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail."<sup>55</sup> This principle, known as the "Anti-Dissection Rule" does not, however, preclude identifying and separately considering component parts as a preliminary step in evaluating likely consumer reaction to a mark as a whole, or as part of determining whether some elements are "functional" and therefore ineligible for protection.<sup>56</sup>

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54. *Id.* § 7.14[1], at 7-60.

55. *Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545-46 (1920); *Official Airline Guides, Inc. v. Goss*, 6 F.3d 1385, 1392 (9th Cir. 1993) ("[T]he validity and distinctiveness of a composite trademark is determined by viewing the trademark as a whole, as it appears in the marketplace."); *Little Caesar Enters., Inc. v. Pizza Caesar, Inc.*, 834 F.2d 568, 571 (6th Cir. 1987) (citing MCCARTHY, *supra* note 24, § 23:22 (2 ed. 1984)). See generally 1 MCCARTHY, *supra* note 24, §§ 7.14[2], 11.10[2] ("The Anti-Dissection Rule"). McCarthy explains that "a combination of separate elements must merge into a single unitary commercial impression to constitute a single registerable trademark." *Id.* § 7.01[1][e], at 7-9 (footnote omitted).

56. Despite a theoretical antagonism to "dissecting" marks, in practice courts analyzing trademarks often consider the elements of a mark. Courts must often at least *identify*, if not actually analyze, a trademark's elements if only to describe it sufficiently in an opinion. See, e.g., *Smith Fiberglass Prods., Inc. v. Ameron, Inc.*, 7 F.3d 1327, 1328 n.1 (7th Cir. 1993) (providing particularly detailed description of mark involving "spiral lines," contrasting colors, and "uniformly spaced intervals"); *Ideal Toy Corp. v. Plawner Toy Mfg. Corp.*, 685 F.2d 78, 80 n.3 (3d Cir. 1982) (comparing detailed description advanced during oral argument, of mark's "monochromatic colors," "black grid pattern," and "square patches," to somewhat simplified description used by the district court). Consideration of a mark's components may be an appropriate step in the court's determination of a mark's overall effect, and in some cases a necessary step in the court's determination of a composite mark's distinctiveness. *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1530 (4th Cir. 1984) ("[W]hile a composite term, including disclaimed words or figures, is to be considered in its entirety in determining validity of a trade mark, it is a settled principle of trade mark law that '[t]he dominant part of a mark may be given extra weight on the issue of likelihood of confusion.'" (quoting *Continental Scale Corp. v. Weight Watchers Int'l*, 517 F.2d 1378, 1381-82 (C.C.P.A. 1975))); 1 MCCARTHY, *supra* note 24, § 11.10[2], at 11-48 to 11-49 (citing *In re Hester Indus., Inc.*, 230 U.S.P.Q. (BNA) 797 n.5 (T.T.A.B. 1986)). But see *Official Airline Guides*, 6 F.3d at 1392 (rejecting this approach).

Courts will also isolate and study components of marks to determine if they are functional and therefore ineligible for protection. See, e.g., *Fabrication Enters., Inc. v. Hygenic Corp.*, 64 F.3d 53, 59 (2d Cir. 1995) ("In order properly to account for [the



Accepting the analysis advanced above would have led to the result that the Respondent sought: A mark of "color alone" would have been found unenforceable under the Lanham Act. Consequently, color would have been protectable only in connection with other elements.

In practice, however, the reasoning used to reach this result would have favored the Petitioner's position. The holding that "color alone" cannot be an enforceable trademark would not have flowed from an analysis of Congress' purpose in its statutory enactments,<sup>57</sup> or a rejection of the "color depletion," "shade confusion" and "functionality" arguments.<sup>58</sup> Rather, the holding would have rested on the recognition that "color alone" is an impossibility. Moreover, while the proposed holding would have protected color only in combination with other design elements, it would not have precluded registration of Qualitex's mark. Once construed as a mark consisting of a solid green-gold color blanketed over a press pad without variation in saturation or brightness, Qualitex's mark becomes recognizable as an ordinary composite mark to which traditional trademark principles can be applied.<sup>59</sup>

The Court would have barely created a ripple in the established jurisprudence by recognizing that *all* trademarks are composites of elements, some of which are so basic that they are always present if not always acknowledged. The established law analyzes trademarks, whether characterized as "composite" or not, in the same way.<sup>60</sup> Marks would have continued to be evaluated according to their "overall effect," with color simply an element contrib-

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anticompetitive effects of protecting functional elements in trade dress], a court must examine a number of variables, including (1) the degree of functionality of the similar features of the product, (2) the degree of similarity between the non-functional (ornamental) features of the competing products, and (3) the feasibility of alternative designs that would not impair the utility of the product." (citing *Stormy Cline Ltd. v. ProGroup, Inc.* 809 F.2d 971, 977 (2d Cir. 1987)).

57. See *Qualitex*, 115 S. Ct. at 1307-08 (construing the legislative history of the Lanham Act and its amendments).

58. See *id.* at 1305-07.

59. See *supra* notes 53-56 and accompanying text.

60. See *supra* notes 53-56 and accompanying text.

uting to the overall design.<sup>61</sup> New to the analysis of trademarks would have been an increased sensitivity to latent design elements previously not identified but which should be considered as part of the totality. The more abstract question—"Can color alone serve the trademark function?"—would have been laid to rest as irrelevant.

There is an indication that some members of the Supreme Court,<sup>62</sup> the Patent and Trademark Office,<sup>63</sup> some of the parties<sup>64</sup> and even some of the lower courts that previously considered the issue<sup>65</sup> sensed the imprecision with which the issue was framed. In oral argument, the Justices seemed perplexed by precisely the question raised in this Article, when they implicitly acknowledged that the mark Qualitex sought implicated not only color, but configuration (i.e., other design elements) as well:

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61. See *supra* notes 53-56 and accompanying text.

62. See *infra* note 66 and accompanying text.

63. See, e.g., TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1202.04(e) (2d ed. 1993). The pre-*Qualitex* edition of the Patent and Trademark Office's manual contained this language regarding submission of color marks: "The burden of proof in such a case is substantial . . . [W]here an applicant seeks registration for *overall* color, registration is refused irrespective of any showing of acquired distinctiveness if there is a competitive need for colors to remain in the industry." *Id.* (emphasis added) (citations omitted).

64. The Respondent, for example, incorporated in its brief a definition of "color per se" that implicitly recognized that the term incorporates the notions of "uniform[ity]" and plainness of design (i.e., "solid"). Respondent's Brief at 6 ("A color per se is a color used in a uniform, non-distinctive manner and not in connection with any definite or arbitrary symbol or design." (citing 1 MCCARTHY, *supra* note 24, § 7.26 (2d ed. 1984))). The Respondent asserted that *Qualitex* did not actually involve a trademark in color per se, but rather that it implicated trade dress protection for "mere product color." Respondent's Brief at 4-5. In this sense, at least implicitly, Respondent recognized that the issue was not protection of mere color, but the way in which the color was used.

65. For example, the *Owens-Corning* opinion contains this language:

An overall color is akin to an over-all surface design, for which trademark registration has been held to be available when the statutory requirements are met. See, e.g., *In re Todd Co.*, 290 F.2d 597, 600, 129 U.S.P.Q. 408, 410 (C.C.P.A. 1961) (registration on the Supplemental Register of a pattern of green parallel lines for safety paper products).

*In re Owens-Corning Fiberglas*, 774 F.2d 1116, 1123 (Fed. Cir. 1985). With this passage, the *Owens-Corning* court distinguished between a solid color, which it termed an "overall color," and stripes, which it termed "an over-all surface design." *Id.* Overall color is not only "akin" to an over-all surface design: it is one. The district court in *Qualitex* recognized that Qualitex's mark was at least analogous to a "design." *Qualitex*, 1991 WL 318798, at \*6 ("[n]on-primary color, akin to an overall surface design") (emphasis added).

QUESTION: [W]hy is the issue phrased as broadly as it is in the questions presented? You're not asking for a monopoly on this color. You're asking for a monopoly on the color used on this particular ironing pad. Why is that different from a trademark on this color in a triangle, for example?

MR. MULAK: Well, that—that is a—that is a symbol attached to a color which may create a trademark. It's different because our whole pad is in the one color—

...

QUESTION: Which is always in a particular shape, is it not? It's kind of a long, narrow—

MR. MULAK: Yes.

QUESTION: But why is that different than if you just trademarked a triangle of this color.

...

QUESTION: [Y]ou're not claiming a monopoly on the color on other products, or on other shapes, and I don't understand why this case is different than the ordinary trademark case with the triangle.

MR. MULAK: Well, this case is no different in terms of the perspective of this Court deciding whether or not color alone is a trademark, that's exactly correct.

QUESTION: *But you're not deciding that color alone is a trademark. You're deciding that color in this particular configuration on this particular product is a trademark.*

MR. MULAK: No, Your Honor, I don't go so far as to talk about configuration. Configuration may be another separate element tied into trademarks, per se, that are allowed in color right now. For instance, a configuration of the red cross, that has been trademarked over the years, and that is a configuration, so that when Your Honor puts the word "configuration" into this trademark, it totally takes me into a whole different perspective as well as into different trademark law. We're talking about just color alone applied to a product, and that

product is a press pad.<sup>66</sup>

The Court apparently accepted Qualitex's attorney's explanation. Consequently, the opinion lacked any reference to the role that latent design elements necessarily play in all "color marks."

E. *Did the Court Violate the Anti-Dissection Rule?*

If the Court really meant what it said, that color "pure and simple" deserves protection as divorced from other design elements that inevitably appear in all graphically represented marks, then *Qualitex* violates the Anti-Dissection Rule. As distinguished from copyright,<sup>67</sup> trademark law does not pick and choose which elements of a mark to protect.<sup>68</sup> *Qualitex*'s mark was comprised of at least seven elements, as described above.<sup>69</sup> To mesh *Qualitex* with the Anti-Dissection Rule, all of these elements would have to be protected as part of *Qualitex*'s composite mark, and not merely hue or color.

F. *Immediate Effect of Qualitex*

As a practical matter, application of the standard test for "likelihood of [consumer] confusion," the "keystone" of infringement, will prevent trademark registrants such as *Qualitex* from having a true monopoly on a particular color.<sup>70</sup> For example, under the analysis set forth in *Polaroid Corp. v. Polorad Elecs. Corp.*,<sup>71</sup> a leading test for likelihood of confusion, courts are required to consider both the "proximity of the products," and the "degree of similarity" between the two marks being compared, as well as other variables:

[T]he prior owner's chance of success is a function of many variables: the strength of [the prior owner's] mark, the degree of similarity between the two marks, the proximity of the products, the likelihood that the prior owner will bridge the gap, actual confusion, and the reciprocal of de-

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66. Oral Argument, at 16-18 (emphasis added).

67. See *infra* text accompanying notes 148-65.

68. See *supra* notes 53-56 and accompanying text.

69. See *supra* text accompanying note 44.

70. See generally 3 MCCARTHY, *supra* note 24, § 23.

71. 287 F.2d 492 (2d Cir.), *cert. denied*, 368 U.S. 820 (1961).

fendant's good faith in adopting its own mark, the quality of defendant's product, and the sophistication of the buyers.<sup>72</sup>

Consideration of "proximity of the products" will ensure that even under *Qualitex*, registration of a color by one manufacturer will not necessarily preclude its use by another manufacturer on a different product. Similarly, consideration of "actual similarity" may mean that a mark that uses precisely the same color as the registrant's on precisely the same product, but in a different configuration—for example as stripes<sup>73</sup>—is noninfringing. Any imprecision in *Qualitex*'s holding, therefore, may be remedied through application of the *Polaroid* factors and other tests for infringement.

Furthermore, protection of "color" marks under the *Qualitex* holding will not necessarily prevent other manufacturers from registering marks that incorporate a color previously registered by a competitor. Under the "related goods" test applied by the Trademark Office, registration of a new mark will be refused only "if [the mark] so resembles a previously registered mark . . . that buyers are likely to think that the applicant's goods . . . come from the same source."<sup>74</sup> Thus, the related goods test requires the Patent and Trademark Office to do the kind of analysis described by *Polaroid* and other cases.

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72. *Id.* at 495. Originally developed for cases involving noncompeting goods, the test is now applied to cases involving competing goods as well. See 3 MCCARTHY, *supra* note 24, § 23.03[1], at 23-43.

73. See *supra* note 48 (noting that stripes generally implicate at least *two* colors).

74. 3 MCCARTHY, *supra* note 24, § 24.12[1][a], at 24-102. The Lanham Act provides: No trade-mark . . . shall be refused registration on the principal register on account of its nature unless it . . . [c]onsists of or comprises a mark which so resembles a mark [previously registered or used] . . . and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive . . . .

15 U.S.C. § 1052 (1994).

## II. THE HISTORY OF THE DISPUTE

Why was the issue presented to the Court in an “all or nothing” way that ignored both the unavoidable presence of color in all graphically represented marks and color’s inevitable dependence on other elements? One answer is that composite marks are considered a subset of trademark law, rather than an inescapable norm. Another answer is that the question developed over so long a period of time, a period incorporating passage of the Lanham Act and its amendment, that perceptions of the contours of the color question had become somewhat fixed.<sup>75</sup>

### A. *Pre-Qualitex Decisions*

The issue before the Supreme Court in *Qualitex* had been previously characterized by courts in a variety of ways, including (1) whether one can receive trademark protection for “color alone”;<sup>76</sup> (2) whether one can receive protection “when the color is an overall color rather than in the form of a design”;<sup>77</sup> and (3) whether a “per se prohibition against protecting color as a trademark” is warranted.<sup>78</sup> The Supreme Court, considering the issue in dictum in 1906, opined probably not: “[w]hether mere color can constitute a valid trade-mark may admit of doubt. Doubtless it may, if it be impressed in a particular design, as a circle, square, triangle, a cross, or a star.”<sup>79</sup>

Following years in which the courts disfavored trademark pro-

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75. The Supreme Court case that set the stage for the debate was *A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co.*, 201 U.S. 166 (1906), which was decided forty years before the Lanham Act liberalized trademark law.

76. *Qualitex Co. v. Jacobson Prods. Co.*, 13 F.3d 1297, 1300, 1302 (9th Cir. 1994), *rev'd on other grounds*, 115 S. Ct. 1300 (1995).

77. *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1118 (Fed. Cir. 1985). This language fails to acknowledge, however, that “overall” is a design. *See supra* note 65.

78. *Master Distribs., Inc. v. Pako Corp.*, 986 F.2d 219, 221 (8th Cir. 1993).

79. *A. Leschen & Sons Rope Co.*, 201 U.S. at 171. In *Leschen*, the Court was not confronted with the issue of whether to grant protection for a particular color, but whether to protect a distinctive use of an undesignated color. The Court concluded that a mark so described was too indefinite to receive protection. *Id.* at 171-72; *see supra* note 49 and accompanying text.

tection of color alone,<sup>80</sup> a circuit split developed.<sup>81</sup> This split reinforced the binary nature of the dispute. On one side were the Eighth and Federal Circuits, which held that color alone could be registered.<sup>82</sup> On the other side were the Ninth and Seventh Circuits, which held that registration of colors was not only undesirable, but unnecessary, in light of the indirect protection color received in combination with other design elements.<sup>83</sup>

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80. The view that color alone should not be protected by trademark law has "deep common law roots." Brian Richard Henry, *Right Hat, Wrong Peg*: In re Owens-Corning Fiberglas Corporation and the Demise of the Mere Color Rule, 76 TRADEMARK REP. 389, 389 (1986).

81. See generally Lawrence B. Ebert, *Trademark Protection in Color: Do It By the Numbers!*, 84 TRADEMARK REP. 379, 391-400 (1994) (summary of split in circuits); Jeffrey M. Samuels & Linda B. Samuels, *Color Trademarks: Shades of Confusion*, 83 TRADEMARK REP. 554, 555-68 (1993) (same); Craig Summerfield, Note, *Color as a Trademark and the Mere Color Rule: The Circuit Split for Color Alone*, 68 CHI.-KENT L. REV. 973, 977-80 (1993) (describing practical effects of circuit split); Schechter, *supra* note 43, at 483-85.

82. *Master Distribs., Inc. v. Pako Corp.*, 986 F.2d 219 (8th Cir. 1993) (holding that no per se rule prohibited trademark protection of manufacturer's use of the color blue on photographic splicing tape); *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116 (Fed. Cir. 1985) (permitting registration of color "pink" for fibrous glass residential insulation). See generally Richard L. Bridge, Note, *Master Distributors, Inc. v. Pako Corporation: Equal Trademark Protection for Color Per Se*, 38 ST. LOUIS L.J. 485 (1993-1994); Kirk L. Peterson, Note, *Master Distributors, Inc. v. Pako Corporation: The Eighth Circuit Refuses to Adopt a Per Se Prohibition on Trademark Protection of a Single Color*, 79 IOWA L. REV. 753 (1994).

83. See, e.g., *Qualitex Co. v. Jacobson Prods. Co.*, 13 F.3d 1297, 1302 (9th Cir. 1994) ("Adequate protection is available when color is combined in distinctive patterns or designs or combined in distinctive logos."), *rev'd on other grounds*, 115 S. Ct. 1300 (1995); *Nutrasweet Co. v. Stadt Corp.*, 917 F.2d 1024, 1027 (7th Cir. 1990) ("Color is not subject to trade-mark monopoly except in connection with some definite arbitrary symbol or design." (quoting *James Heddon's Sons v. Millsite Steel & Wire Works, Inc.*, 128 F.2d 6, 9 (6th Cir. 1942))), *cert. denied*, 499 U.S. 983 (1991); *First Brands Corp. v. Fred Meyer, Inc.*, 809 F.2d 1378 (9th Cir. 1987); see also *A. Leschen & Sons Rope Co.*, 201 U.S. at 171 ("[I]f color be made the essential feature, it should be so defined, or connected with some symbol or design, that other manufacturers may know what they may safely do."); *Owens-Corning*, 774 F.2d at 1128 (Bissell, J., dissenting) ("[C]olor must be in the form of a design to constitute a trademark. . . ."); cf. *Campbell Soup Co. v. Armour & Co.*, 175 F.2d 795, 798-99 (3d Cir.) (implying that color should only be protected "if it is used in combination with a design in the form, for example, of a picture or a geometric figure"), *cert. denied*, 338 U.S. 847 (1949).

Other federal courts of appeals confronting trademark cases implicating the *Owens-Corning* holding that no per se color bar exists decided the cases before them without

Those Circuits opposing registration were heavily influenced by Judge Bissell's dissent in *In re Owens-Corning Fiberglass Corporation*.<sup>84</sup> In his dissent, Judge Bissell adopted the position of pre-Lanham Act courts "that color must be in the form of a design to constitute a trademark."<sup>85</sup> He concluded that "[c]olor uniformly applied to a product is *not* a design because it has not been used in connection [to] or combination with or impressed in some definite arbitrary symbol or design."<sup>86</sup> This view, however, fails to recognize that a uniform application of a color *is* a design.

### B. *Debunking the Traditional Objections*

Those courts rejecting protection of color never questioned the meaning, or meaningfulness, of the phrase "color alone." If anything, they accepted the fiction that a mark can consist only of color. As the *Owens-Corning* dissent illustrates, even those opposing registrability frequently conflated the terms "color alone" and "mere color" with "color uniformly applied" and "overall color."<sup>87</sup> By conflating the terms, the courts avoided confronting what "col-

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taking a position on *Owens-Corning*. See, e.g., *Keds Corp. v. Renee Int'l Trading Corp.*, 888 F.2d 215, 221 (1st Cir. 1989) (declining to decide trademarkability of "color alone" since the color at issue was combined with the nonfunctional shape of the blue label which itself had acquired secondary meaning); *AmBrit, Inc. v. Kraft, Inc.*, 805 F.2d 974, 992 (11th Cir.), *rereported*, 812 F.2d 1531, 1548 (11th Cir. 1986) (where district court had relied on *Owens-Corning* for the proposition that "color alone" could be protected, court of appeals held use of color "royal blue" on foil wrapper for ice cream functional—as suggestive of coldness—and therefore not protectable), *cert. denied*, 481 U.S. 1041 (1987).

84. 774 F.2d 1116 (Fed. Cir. 1985); see, e.g., *Qualitex*, 13 F.3d at 1301-02 (discussing the Bissell dissent); *Nutrasweet*, 917 F.2d at 1027 (same). See generally Hillel I. Parness, Note, *The Curse of the Pink Panther: The Legacy of the Owens-Corning Fiberglass Dissent and Its Role in the Qualitex Supreme Court Appeal*, 18 COLUM.-VLA J.L. & ARTS 327 (1994).

85. *Owens-Corning*, 774 F.2d at 1128 (Bissell, J., dissenting) (citations omitted).

86. *Id.* at 1130 (Bissell, J., dissenting).

87. See *id.* at 1118 ("overall color"); *id.* ("mere color" (quoting *A. Leschen & Sons Rope Co.*, 201 U.S. at 171)); *id.* at 1123 ("overall color"); *id.* at 1128 ("overall color" (Bissell, J., dissenting); *id.* at 1130 ("[c]olor uniformly applied" (dissent); *id.* at 1131 ("color itself" (dissent); cf. *Master Distribs., Inc. v. Pako Corp.*, 986 F.2d 219 (8th Cir. 1993) (repeated use of term "color alone" to refer to uniform coating of photographic splicing tape in blue); *Nutrasweet*, 917 F.2d at 1027 ("a particular color"); *id.* ("overall color"); *id.* ("color alone").



or alone" really means.

Moreover, the theories historically invoked to oppose protection for "color alone," primarily the color depletion and shade confusion arguments,<sup>88</sup> implicitly incorporated the notion that color can meaningfully be considered in isolation. The concerns underlying both the color depletion and the shade confusion arguments fizzle, however, when "a color alone" is understood to mean a particular solid color applied all over without variation. Does the fact that the Owens-Corning Company covers fiberglass insulation in solid, opaque pink applied all over without variation in hue, brightness, saturation or degree of opaqueness<sup>89</sup> preclude another manufacturer from registering or using stripes of opaque pink applied all over without variation? Probably not.<sup>90</sup> Consequently, what palette is depleted by permitting registration of the solid pink mark? When "color alone" is understood to mean color in combination with other design elements (e.g., "solid," "applied all over" and "without variation"), the availability of other potentially noninfringing uses of *exactly the same color* becomes obvious.

With respect to the shade confusion issue, two competitors could, in theory, adopt *precisely the same shade* without creating confusion simply by combining the shade with other design elements (e.g., one solid, the other striped or swirled). The fact that a particular shade is used on two marks does not implicate factfinder competence. What presents the difficulty is if both marks draw on the same combination of elements, including elements like "solid" and "applied all over" that have been absent from the court's considerations of "color" marks to date.

Marks consisting of combinations of several colors have tradi-

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88. See generally Lupo, *supra* note 29, at 638-48 (describing traditional objections to registration of color marks).

89. See *Owens-Corning*, 774 F.2d 1116 (holding color pink protectable as applied to fiberglass insulation).

90. Conceivably, a consumer could confuse the second comer's use of the first comer's color, but in a different configuration, as an attempt by the first comer to signal a new development in its own product line. The likelihood of consumer confusion of this type would be an issue for litigation; a finding of infringement would not be a certainty. Cf. *infra* note 108 (discussing "strength" of marks).

tionally received protection since "even protecting one *arrangement* 'would leave innumerable other combinations of the same colors or other colors that could be assembled in a multitude of patterns.'" <sup>91</sup> When a "mere color" is understood actually to denote an "arrangement," the same reasoning applies. Consequently, the concerns underlying the shade confusion and color depletion arguments are negated.

### III. PROTECTION OF COLORS AFTER *QUALITEX*

#### A. Properly Identifying the Entirety of the Mark

The recognition that all marks are composites is crucial to avoiding inadvertent violations of the Anti-Dissection Rule caused by protecting only a subset of marks' features. Awareness of the presence of a multiplicity—truly an infinite variety—of latent design elements in the composite mark may also be necessary to avoid overemphasizing some marks' potential anticompetitive affects.

#### 1. Avoiding Violation of the Anti-Dissection Rule

Properly identifying the entirety of a given mark is critical to avoiding Anti-Dissection Rule violations. In *Qualitex*, as described above, the failure to recognize that the mark was a composite meant that certain latent elements were not considered.<sup>92</sup> Consequently, the Court did not accurately consider the entirety of the mark, but instead permitted protection based on identification of only a subset of the mark's features.<sup>93</sup> Conferring protection based on that underdescription of the mark thus violated the Anti-Dissection Rule.<sup>94</sup>

Such misdescriptions may not be limited to latent elements. Consider *Deere & Co. v. Farmhand, Inc.*,<sup>95</sup> the leading case deny-

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91. Henry, *supra* note 80, at 394 n.28 (emphasis added) (quoting *Chevron Chemical Co. v. Voluntary Purchasing Groups, Inc.*, 659 F.2d 695, 703 (5th Cir. 1981), *cert. denied*, 457 U.S. 1126 (1982)).

92. See *supra* part I.D.

93. See *supra* part I.E.

94. See *supra* part I.E.

95. 560 F. Supp. 85 (S.D. Iowa 1982), *aff'd*, 721 F.2d 253 (8th Cir. 1983).

ing protection for mere color on aesthetic functionality grounds. In *Deere*, the court refused to protect the manufacturer's use of "John Deere green" on its tractors, attachments and implements.<sup>96</sup> Protection, in the court's view, would have conferred a disadvantage on competitors since farmers, "concerned with the aesthetics of their farm machinery and prefer[ing] to match their loader[s] to their tractor[s]," would be disinclined to purchase from manufacturers other than Deere.<sup>97</sup>

A fact absent from the *Deere* opinion is that green is not the only color to appear on Deere's tractors and attachments.<sup>98</sup> Deere's farm equipment has traditionally been painted in a highly distinctive green and yellow combination, a scheme that continues to this day.<sup>99</sup> The court apparently focused on the color green because the defendant's allegedly infringing front-loader, although painted "John Deere green," lacked Deere's yellow trim.<sup>100</sup> While the court was apparently cognizant of its obligation to consider the "overall appearance" of the mark,<sup>101</sup> the color "yellow" was notably absent from the court's detailed identification of the numerous features comprising the mark.<sup>102</sup> By effectively excluding the color "yel-

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96. *Id.* at 94-101.

97. *Id.* at 91.

98. The court repeatedly characterized the problem before it as whether to protect the color "John Deere green." See *id.* at 88 (5 mentions); *id.* at 89 & n.4 (5 mentions); *id.* at 91 (1 mention); *id.* at 93 (4 mentions); *id.* at 96 & n.19 (3 mentions); *id.* at 97 & n.20 (2 mentions); *id.* at 98 (1 mention); *id.* at 99 (3 mentions); *id.* at 100 (3 mentions); *id.* at 101 (2 mentions). The word "yellow" does not appear in the opinion, except for a reference to a different "color" case. See *id.* at 97 (citing *Chevron Chem. Co. v. Voluntary Purchasing Group*, 659 F.2d 695 (5th Cir. 1981)).

99. Telephone Interview with Leslie Stegh, Archivist, Deere & Co. (Oct. 25, 1995) [hereinafter Stegh Interview]; Telephone Interview with John Nolan, Senior Patent Counsel, Deere & Co. (Oct. 25, 1995) [hereinafter Nolan Interview]; see also Lee Stratton, *Retired Farmer has a Soft Spot in His Heart for John Deere*, COLUM. DISPATCH, June 16, 1993, at 1F (describing a farmer's "passion" for "John Deere's bright-green tractors with yellow trim"). With respect to Deere tractors, the color scheme of a green body with yellow wheels and a horizontal stripe on the hood dates back to the 1920s. Stegh Interview, *supra*. Deere farm implements were colored green and yellow, as well as other colors, from the 1890s onward; green and yellow predominated beginning in the 1920s, and became the exclusive scheme in the 1940s. *Id.*

100. Stegh & Nolan Interviews, *supra* note 99.

101. See *Deere*, 560 F. Supp. at 89-90.

102. See *id.* In addition to use of "John Deere green," the court discussed these

low" from the mark's "overall appearance," and using that misdescription to determine whether the mark merited protection, the court violated the Anti-Dissection Rule. Indeed, in later litigation over whether Deere's application for trademark protection for its color scheme should be granted, the Trademark Trial and Appeals Board emphasized: "we are not dealing in this case with a single overall color but with two colors applied in a specific and arbitrary fashion."<sup>103</sup>

## 2. Avoiding Creating Problems of Anticompetitiveness

Another reason for recognizing the composite nature of all marks is to prevent creating anticompetitiveness problems where such problems do not exist. Defining a mark by only a subset of its features can make it seem more potentially anticompetitive than it really is. Correlatively, defining a mark in as comprehensive terms as reasonably possible may limit perception of a mark's anticompetitive potential.

These observations follow from the role that "degree of similarity" plays in determining whether an infringer's mark is confusingly similar to the trademark holder's under standard tests for infringement.<sup>104</sup> Especially with "picture and design marks . . . similarity of appearance is controlling."<sup>105</sup> Intuitively, the more features

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features that comprised the whole:

The shape of the loader mast . . . [;] [t]he shape of the mounting frame . . . [;]  
[t]he location of the torque tube . . . [;] [t]he flat top of the bucket . . . [;] [t]he  
location of the lift and bucket cylinders on the knee plate . . . [;] [t]he routing  
of the hydraulic lines . . . [;] [t]he shape and location of the decals . . . [;] [t]he  
elimination of weld-on tabs to mount the cylinders . . . [;] [t]he use of straight  
lines to compliment the contour of the Deere Generation II tractors . . . [;] [t]he  
use of continuous welds . . . [;] [t]he bent-over front lip on the top of the loader  
bucket . . . [;] [t]rim and radii details in crucial locations.

*Id.* (citations omitted). The reference to "[t]rim . . . details in crucial locations" is the closest the opinion came to mentioning the striking and distinctive application of yellow to Deere's tractors and implements.

103. *In re Deere & Co.*, 7 U.S.P.Q.2d (BNA) 1401, 1404 (T.T.A.B. 1988). Deere's application for registration described its mark as "a bright green color, sometimes known as 'John Deere' green and a bright yellow color." *Id.* at 1402.

104. See *supra* note 72 and accompanying text; see also 3 MCCARTHY, *supra* note 24, § 23.07 (discussing role of "[s]imilarity of [a]pppearance" in infringement actions).

105. 3 MCCARTHY, *supra* note 24, § 23.07, at 23-52.5.

a mark is recognized to possess, the larger the universe of potentially noncompeting marks will be, since each feature translates into a potential point of difference. Part of appreciating a mark's complexity, i.e., the variety of potential points of difference, is to appreciate the presence of latent elements in the mark.

*Deere* is an example of the court and parties creating more of an "anticompetitiveness" problem than actually existed—in that case by ignoring *nonlatent* elements.<sup>106</sup> By characterizing *Deere*'s trademark only as "green," *Deere* and the court obscured a substantial difference between *Deere*'s mark and that of its competitors: one mark involved two colors and the other involved only one color.<sup>107</sup> Whether that difference was enough to avoid a finding of "confusingly similar" is another question altogether—one not considered by the court since it felt it had to deny protection to *Deere*'s mark on the grounds of (1) nonprotection of color per se, and (2) aesthetic functionality: the potentially anticompetitive effect of conferring a monopoly on a specific color which competitor's may need to facilitate matching with their own products.<sup>108</sup>

In fact, competitors could have considered a multiplicity of alternative designs matching *Deere*'s tractor. Some combinations that might have matched *Deere*'s green and yellow design include: solid green; green stripes on an unfinished metal background; a yellow background with green trim; some combination of green, white and yellow; a solid green background with an unobtrusive, but clearly visible, purple trim; a solid black background with green trim. Whether any (or all) of these marks would have been

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106. See *supra* notes 95-103 and accompanying text.

107. See *supra* text accompanying notes 100-02.

108. See *supra* notes 30-31 and accompanying text. A competitor applying the same yellow and green hues in exactly the same arrangement on its own tractors or farm implements and attachments would infringe *Deere*'s mark. If *Deere*'s mark were found to be sufficiently "strong," it is possible a competitor's use of any arrangement of *Deere*'s green and yellow colors would be infringing. If *Deere*'s mark were *really* strong, it is even possible that merely applying *Deere*'s shade of green on a tractor or farm implement would be infringing. That result would follow not, however, from an underdescription of *Deere*'s mark; rather, it would be based on the concept of mark "strength," which in turn reflects the extent to which consumers have developed an awareness of the connection between a given mark and the source of the goods. See generally 2 MCCARTHY, *supra* note 24, § 11.24; *infra* note 112.

"confusingly similar" to Deere's is a question for the factfinder. In order for aesthetic functionality to carry weight, the court would have had to find that *every one* of the infinite variety of arguably matching designs was confusingly similar to Deere's yellow and green.

In *Deere*, misdescription of the mark ultimately distracted the court from the concrete issue presented: whether the two marks were confusingly similar. The consequence of ruling on the theoretical issue of protectability—an issue which only emerged through the court's acceptance of the parties' misdescription—was to foreclose prematurely the opportunity to litigate the concrete factual issues presented by the competing marks. Underdescription of marks, and attendant shifts in litigation focus from concrete issues of infringement to theoretical issues of protectability, may be systemic in trademark law.<sup>109</sup>

In *Qualitex* and the true "mere color" cases, anticompetitiveness problems are created when the presence of *latent* elements is ignored. Consider protection of "color alone," in the sense of color not combined with any other elements, including latent elements, in effect, disembodied color. Such protection would, at least in theory, place greater restraint on competitors than is required. If the fact that Qualitex has a trademark for "green-gold alone" means that no other manufacturer of similar pads can use any "green-gold," not even a small splotch, then protection is too broad. Clearly some "green-gold" could be used—perhaps in combination with other colors, or in a different but distinctive application—without creating confusion in consumers' minds as to the source of the product.<sup>110</sup> It is not "green-gold alone" that merits

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109. See *infra* text accompanying notes 173-75. See, e.g., *Knitwaves, Inc. v. Lollytogs, Ltd.*, Nos. 94-7968, 94-9024, 1995 WL 673250, at \*9-10 (2d Cir. Nov. 13, 1995) (rejecting defendant's attempt to overemphasize anticompetitive potential of plaintiff's mark by underdescribing its material components).

110. Careful, nonconfusing and noninfringing use by one manufacturer on its own products of a color often linked to a competitor's products might in fact serve a useful function for manufacturers and consumers alike. It could serve to say "this product is like my competitor's but it is from another company." This is the theory behind "store brands" of popular products such as household cleaning cleanser.

protection, but "solid," "green-gold," "all over," and "without variation," if the goal is merely to prevent consumer confusion.<sup>111</sup>

### B. Identifying Latent Elements After *Qualitex*

While *Qualitex* accepted the notion that "color alone" may comprise a protectable trademark, the Court's holding does not prevent courts from accurately identifying the latent elements in marks as appropriate. The Court's failure to recognize the inherent composite nature of all marks should not inhibit other courts from doing so.

Accurate identification and recognition of the many elements present in trademarks can be readily incorporated into the *Polaroid* analysis and other existing doctrines with little evolution in the law. Consider some of the traditional principles: the distinction between the scope of protection conferred on "weak" versus "strong" marks;<sup>112</sup> exclusion from protection of designs that are purely decorative and ornamental and therefore incapable of serving a trademark's source-identifying function;<sup>113</sup> and the test of whether a mark consisting of a background design, or a uniform covering for the surface of a package or product, is protectable: whether a "separate impression" in the mind of the consumer is created.<sup>114</sup>

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111. In practice, infringement tests such as *Polaroid* will limit the scope of any underdescribed color mark's monopolistic tendencies. See *supra* part I.F.

112. See generally 1 MCCARTHY, *supra* note 24, § 11.24. Marks exist, in some sense, along a continuum, from "weak" to "strong." The strength of a mark affects the scope of protection it will receive, with respect to "market," (i.e., across product lines) "format," and "territory" (i.e., across geographical boundaries). *Id.* § 11.24[1]. Strength may be synonymous with distinctiveness. See *McGregor-Doniger, Inc. v. Drizzle, Inc.*, 599 F.2d 1126, 1131 (2d Cir. 1979) ("The term 'strength' as applied to trademarks refers to the distinctiveness of the mark, or more precisely, its tendency to identify the goods sold under the mark as emanating from a particular, although possibly anonymous, source.") (citation omitted).

113. See generally 1 MCCARTHY, *supra* note 24, § 7.06. Purely ornamental and decorative marks are not entitled to trademark protection. See, e.g., *Major Pool Equip. Corp. v. Ideal Pool Corp.*, 203 U.S.P.Q. (BNA) 577, 582 (N.D. Ga. 1979) (swimming pool tile design held "mere refinement of the general ornamental concept, rather than . . . a trademark"); *In re David Crystal, Inc.*, 296 F.2d 771 (C.C.P.A. 1961) (registration denied for purely ornamental mark of stripes on socks where secondary meaning was not shown).

114. See, e.g., *Vision Sports, Inc. v. Melville Corp.*, 888 F.2d 609, 613 (9th Cir. 1989) ("A background design, when used in connection with a word mark in such a way as to create in the minds of the consuming public a commercial impression, separate and apart from the word mark itself, may be protected as a separate mark."); *In re Chemical*

The fact that a hue is applied uniformly as a solid rather than in combination with other hues or with some fanciful variation in application may increase its chances of being found "weak."<sup>115</sup> Similarly, a solid color applied uniformly may be more—or less—likely to be considered "decorative or ornamental" than one more fancifully applied.<sup>116</sup> For example, it is sometimes suggested that the greater the repetition in a pattern, the more likely that the pattern will lose its distinctiveness and be perceived by the buyer as mere ornamentation.<sup>117</sup> Presumably, since a solid represents in some sense an infinite repetition of a splotch of color, solids as a group will be more likely to be found merely decorative. The relative ordinariness of a solid applied uniformly, in comparison with other types of applications of color, may mean that solids as a group will less frequently be found to create "a separate impression" in the minds of consumers when used as an overall covering

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Dynamics, Inc., 839 F.2d 1569, 1570 (Fed. Cir. 1988) (similar). See generally 1 MCCARTHY, *supra* note 24, § 7.08.

115. See, e.g., Lupo, *supra* note 29, at 647 n.50 ("Color marks by their nature are inherently weak marks and therefore may require a greater showing of secondary meaning than would be required for a word or design mark."). Lupo identifies three reasons why color marks are generally considered weak: 1) the "available palette of colors is more limited" than the available palette of other types of marks; 2) the fact that all goods have colors; and 3) the tendency of consumers to perceive colors as mere ornamentation. *Id.* at 647. He notes, however, that "instances [ ] when a color is inherently distinctive or has achieved a high degree of consumer recognition as to source of origin justify entitling the mark to a broad area of protection . . . [a]n approach consistent with treatment of any other strong mark." *Id.*

116. See, e.g., *In re Owens-Corning Fiberglass Corp.*, 221 U.S.P.Q. (BNA) 1195, 1198 (T.T.A.B. 1984) ("Color—even color applied over the entire surface of the goods—is really nothing other than a type of product ornamentation."), *rev'd on other grounds*, 774 F.2d 1116 (Fed. Cir. 1985); see also *Mana Prods., Inc. v. Columbia Cosmetics Mfg.*, 65 F.3d 1063, 1070 (2d Cir. 1995) ("While there is no fixed rule for the amount of proof necessary to prove secondary meaning, in the case of a color mark for a trade dress the burden is heavy because color marks by their very nature are not generally distinctive."); Lupo, *supra* note 29, at 663-64 ("[T]he public normally perceives color as mere ornamentation and not as a source identifier."); Schechter, *supra* note 43, at 481 ("When a consumer sees a product with a particular coloration, the consumer usually believes the color to be mere decoration, not an indication of the product's source.").

117. See, e.g., *Major Pool Equip. Corp.*, 203 U.S.P.Q. (BNA) at 582 (noting that "deadening repetition of even a distinctive design" may be perceived as "mere [ ] ornamentation"). See generally 1 MCCARTHY, *supra* note 24, § 7.11, at 7-54.



or background.<sup>118</sup>

In addition, some particular solid colors may be less likely to receive protection than others. For example, the fact that the color black is compatible with other colors increases the chance that its application as a solid will be found functional.<sup>119</sup> The same might be said of the color white, untinted transparent substances, and possibly primary colors. Similarly, the fact that black is in a sense a "default" choice may limit its chances of being considered "arbitrary."<sup>120</sup> Recognizing the fact that colors arise in trademarks only as elements of composite marks does not preclude generalizations about how marks which purport to present distinctive uses of a solitary color will be treated.

*C. Clarifying Existing Law: Protection of Colors in Liquids*

Recognizing that a trademark for a "color alone" is really a trademark for "a solid color applied all over without variation" does not necessarily change the applicability of the above principles. It may, however, increase the precision of their application.

At the very least, the recognizing that all marks are composites explains a series of holdings that has tended to elude precise explanation. It is generally acknowledged that trademark protection should not be conferred on the color of liquids.<sup>121</sup> For example, protection has been denied, on the basis of attenuated findings of "functionality" or other reasons, for the use of the color pink in liquid stomach preparation,<sup>122</sup> the chocolate color of a medicinal

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118. *Cf. Campbell Soup Co. v. Armour & Co.*, 175 F.2d 795, 799 (3d Cir.) ("The mere division of a label into two background colors, as in this case, is not, however, distinct or arbitrary . . ."), *cert. denied*, 338 U.S. 847 (1949).

119. *See, e.g., Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 1531-32 (Fed. Cir. 1994), *cert. denied*, 115 S. Ct. 1426 (1995).

120. *See, e.g., Mana Prods., Inc. v. Columbia Cosmetics, Mfg.*, 858 F. Supp. 361, 367 (E.D.N.Y. 1994) ("[I]t strikes this Court as nonsensical to label the color black as arbitrary because many other options were available."), *aff'd*, 65 F.3d 1063 (2d Cir. 1995).

121. 1 MCCARTHY, *supra* note 24, § 7.19, at 7-83 ("Claims to trademark rights in the color of a liquid product or medicinal preparation have usually been refused.").

122. *See Norwich Pharmacal Co. v. Sterling Drug, Inc.*, 271 F.2d 569, 572 (2d Cir. 1959) (refusing to enjoin competitor's use of pink in medicinal product where likelihood of confusion had not been established, and where the color was found functional since it

liquid<sup>123</sup> and amber in mouthwash.<sup>124</sup> These holdings supplement the Supreme Court's observation in 1920 that a liquid beverage's "coloring matter is free to all who can make it if no extrinsic deceiving element is present."<sup>125</sup>

There is another reason, however, to deny protection in liquid cases. When a liquid is colored, the configuration of the color is necessarily "solid," "applied all over," and "without variation." Stripes, for example, are an impossibility for all but the thickest liquids that approach the consistency of pastes.<sup>126</sup> Thus, conferring a trademark monopoly in this context could deplete the available palette from which competitors may choose. With respect to colors of liquids, there truly is a relatively limited number of arrangements available, and removing one could unduly handicap competitors. Colors of liquids, therefore, may be the only context in which the "color depletion" argument has some merit and viability.

The attraction of obtaining a color mark for a liquid is apparent: it may be the only way to identify the source of a liquid that changes containers as it moves through the distribution chain. Liquids are necessarily sold in containers which themselves are capable of supporting a variety of identifying marks. However, liquid products may be mass produced at one location and then distributed to resellers so that the original packaging, with its

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"present[ed] a pleasing appearance" and was soothing to the person who imbibed the product), *cert. denied*, 362 U.S. 919 (1960).

123. See *William R. Warner & Co. v. Eli Lilly & Co.*, 265 U.S. 526, 531-33 (1924) (refusing to enjoin competition from using chocolate in solution for coloring and flavoring purposes and as suspension medium, but suggesting to district court that it impose on remand a decree that would require clear labeling with directions to druggists not to substitute Petitioner's product for Respondent's).

124. See *Warner Lambert Co. v. McCrory's Corp.*, 718 F. Supp. 389, 396 (D. N.J. 1989) (amber color of liquid mouthwash held functional since it "signifies an unflavored, medicinal mouthwash").

125. *Coca-Cola Co. v. Koke Co. of Am.*, 254 U.S. 143, 147 (1920).

126. Consider, for example, striped toothpastes. Some types of alcoholic drinks, and indeed some other nonhomogenized liquids, such as salad dressing, may consist of levels of different colors. These examples do not present an exception, however, to the observation that individual liquids are generally capable only of having a solid "all over" design, since these examples involve combinations of *multiple* liquids of different densities and colors.

source-indicating features, is never seen by the end consumer.<sup>127</sup> The simplest way, and possibly the only sure-fire way, then, to ensure that an end user recognizes that a liquid product emanates from a particular source is to color it.

Consider, for example, the case of a milk producer who wishes to capitalize on the health-conscious consumer market by selling milk products from rbGH-free cows.<sup>128</sup> Recognizing that milk is often sold without its original packaging to consumers in restaurants, the manufacturer hits upon coloring its milk green to distinguish it from milk produced from cows that received bovine growth hormone injections. The producer hopes, in this way, to generate good will in consumers who might otherwise be unaware of its products.

If this producer receives protection for the color green in milk products and is successful at selling his or her product, other dairy producers may also seek to color their products, potentially implicating concerns over "shade confusion" and "color depletion." As a practical matter, if the campaign were truly successful, green could become equated in consumers' minds with "rbGH-free" rather than with a particular manufacturer. In this event, "genericide," rather than a general prohibition on color marks, would be the basis on which protection would be denied.<sup>129</sup>

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127. The fact that liquids are dependent on the containers that hold them raises an interesting issue. If one manufacturer succeeds in trademarking a translucent green bottle, cf. *California Crushed Fruit Corp. v. Taylor Beverage & Candy Co.*, 38 F.2d 885 (D. Wis. 1930) (considering trademark protection for "black, opaque, 'champagne' shaped bottle"), is it infringed by a similarly shaped blue translucent bottle that contains a yellow liquid, the combined effect of which is precisely that green protected by the first manufacturer's trademark? See *Norwich Pharmacal*, 271 F.2d at 573 ("Limitation of the injunction to the suppression not of the pink colored medicine but only of the color which the purchasing public might see through a clear glass bottle is indicative that the [district] court felt that the plaintiff had preempted unto itself exclusively and forever this appearance of a pink color for a stomach medicine."), *cert. denied*, 362 U.S. 919 (1960).

128. rbGH is the common name for the bovine growth hormone BST which is used to increase milk production in cows. James Ridgeway, *Robocow: How Tomorrow's Farming Is Poisoning Today's Milk*, VILLAGE VOICE, Mar. 14, 1995, at 27.

129. The term "genericide" refers to the process by which a mark ceases to indicate a source and instead is understood by the public to refer to the product itself. See generally 2 MCCARTHY, *supra* note 24, § 12. Generic designations cannot receive trademark

#### D. Can Color Marks Be Inherently Distinctive?

*Qualitex* left unanswered a significant issue, one that was identified and pressed by the Court extensively during oral argument: can a color be so inherently distinctive as not to require a showing of secondary meaning<sup>130</sup> prior to registration?<sup>131</sup> Under the Lanham Act, inherently distinctive marks do not require proof of secondary meaning as a prerequisite for registrability, while "merely descriptive" marks do.<sup>132</sup> The Petitioner's attorney, the representative of the United States, and the attorney for the Respondent each declined the Court's repeated invitations during oral argument to hypothesize an inherently distinctive color.<sup>133</sup> Since the Court ac-

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protection since, by definition, they can no longer serve a trademark function (source-identification). Genericide is the danger against which most popular marks must guard. Colors on liquids may be particularly prone to genericide precisely because of liquids' dependence on packaging. If the packaging is absent so that the color of the liquid is clearly seen, the association in the consumer's mind is that between the product and its color, and not that between the color and the product's source or the product and its source.

130. See *supra* note 24.

131. See Oral Argument at 13 (Petitioner's attorney explains that he is not asking the Court to decide this issue).

132. See 15 U.S.C. §§ 1052(e)-(f) (1994). Marks that are "arbitrary," "fanciful," or non-descriptive but "suggestive" are considered "inherently distinctive," and thus do not require secondary meaning as a prerequisite to registration. See 2 MCCARTHY, *supra* note 24, § 16.02, at 16-4. The Supreme Court extended this classification scheme to "trade dress" cases in *Two Pesos, Inc. v. Taco Cabana, Inc.*, 112 S. Ct. 2753, *reh'g denied*, 113 S. Ct. 20 (1992).

Other courts which considered, prior to *Qualitex*, whether secondary meaning is required for colors generally held that it was. See e.g., *Master Distribs. Inc. v. Pako Corp.*, 986 F.2d 219, 223 (8th Cir. 1993) ("[A] manufacturer's mere use of a certain color will not automatically grant it proprietary rights—the manufacturer must establish all the normal requirements for trademark protection, including secondary meaning."); see also *Burgunder*, *supra* note 28, at 600 (reasoning that secondary meaning should be required "[s]ince the set of basic color hues is limited [and] there may be a potential for market inefficiencies, just as with descriptive marks") (footnotes omitted); *Ebert*, *supra* note 81, at 406 (advocating a system of protection of colors in which registrants would first have to prove nonfunctionality and secondary meaning); *Summerfield*, *supra* note 81, at 983-84 ("Secondary meaning must be shown for a color to be registered as a trademark." (citing *In re Owens-Corning Fiberglass Corp.*, 774 F.2d 1116, 1124 (Fed. Cir. 1985))).

There is some disagreement regarding whether color marks are, by nature, descriptive. See *Peterson*, *supra* note 82, at 756-57 & nn.32-34; *Bridge*, *supra* note 82, at 492 (noting that "courts generally consider color marks as descriptive").

133. See, e.g., Oral Argument at 3, *passim* (repeated questions regarding whether

cepted the district court's determination that Petitioner's use of the green-gold color had acquired secondary meaning, it was not required to resolve the issue of whether a color "pure and simple" could be inherently distinctive.<sup>134</sup>

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showing secondary meaning should be a prerequisite to registration of colors, and whether any color could be "inherently distinctive"). One colloquy is instructive of the Court's persistence and mounting frustration:

QUESTION: [W]e're asking you, is it possible [for a color to be inherently distinctive and not require secondary meaning]? If you wanted it, could you get it?

MR. MULAK: That's a very unique question in the sense that if it—

QUESTION: It's not unique, it's been asked about 20 times from up here and—

QUESTION: We've gotten about five different answers.

QUESTION: —and we still don't have an answer.

MR. MULAK: If it is inherently distinctive in color, which we, of course, would argue that the Qualitex color is distinctive—we're not arguing it's inherently distinctive. We established our trial court record by proving after 30 years of use that people have recognized it as a sole source. We're not taking it that far as to say, this color is inherently distinctive.

QUESTION: *You don't want us to reach that issue?*

MR. MULAK: *That's correct. We've not asked that point.*

Id. at 12-13 (emphasis added).

134. Some have read *Qualitex* as requiring that secondary meaning be established before marks consisting of "a single color" will be protected under the Lanham Act. See, e.g., *Knitwaves Inc. v. Lollytogs Ltd.*, Nos. 94-7968, 94-9024, 1995 WL 673250, at \*12 (2d Cir. Nov. 13, 1995); *Fabrication Enters., Inc. v. Hygenic Corp.*, 64 F.3d 53, 58 n.3 (2d Cir. 1995); Schechter, *supra* note 43, at 505, 509-11; Mark S. Sommers, *Owning Your Own Colour*, TRADEMARK WORLD (United Kingdom), May 1995, at 18, 19 (reading *Qualitex* as holding that "colour must earn its right to trademark protection, just like descriptive words or symbols do, by attaining secondary meaning in the minds of consumers").

The Supreme Court accepted the district court's finding that Qualitex's color mark had acquired secondary meaning. *Qualitex*, 115 S. Ct. at 1308 ("[I]n light of the District Court's here undisputed findings . . ."); see also *id.* at 1305 ("Having developed secondary meaning (for customers identified the green-gold color as Qualitex's), it identifies the press pads' source."); *id.* at 1308 ("Having determined that a color may *sometimes* meet the basic legal requirements for use as a trademark . . .") (emphasis added). Therefore, the question of whether a color mark could be registered on the basis of its inherent distinctiveness (i.e., without secondary meaning) was not before the court. See also *supra* notes 132-33. Any inclination in the opinion to decide that issue one way or another is merely dictum. Cf. Paul R. Morico, *Protecting Color Per Se in the Wake of Qualitex v. Jacobson*, 77 J. PAT & TRADEMARK SOC'Y 571, 571 (1995) (noting that "[c]olor marks are *rarely* inherently distinctive [and] often require substantial promotion to acquire secondary meaning," thereby implying that *some* color marks can be inherently distinctive,

As framed by the Court during oral argument, the question was whether *a particular color alone* could be inherently distinctive.<sup>135</sup> As a consequence, the Court framed its hypotheticals in terms of “weird color[s]” such as “lime yellow,” “lavender,” and “hot neon pink.”<sup>136</sup> The question was hard to answer precisely because color is something that cannot be considered in isolation. As Qualitex’s attorney reiterated, the company was not seeking to protect against use of “green-gold” on products generally, but merely against use on the types of pads that it produced.<sup>137</sup> A particular color may be distinctive in one context and not distinctive in another, a reality that is obscured by consideration of the hypothetical trademarkability of “color.”

The more precise, and more easily answered, question is whether a trademark consisting of a solid color blanketed over a particular product without variation can be inherently distinctive. Clearly, the answer is “yes.” Suppose, for example, that Nabisco, concerned with the proliferation of other brands of peanuts, decided to paint its Planter’s cocktail peanuts purple. Its choice of color would indisputably be both “fanciful” and “arbitrary,” given that the color purple is not a natural color for nuts. Given the peculiarity of the choice of color, it seems plausible that consumers merely presented with a bowl of purple peanuts, perhaps in a bar or restaurant, would immediately recognize the product as emanating from a particular source.

According to the principles discussed above, the trademark

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even in *Qualitex*’s wake) (emphasis added); *id.* at 579 (“[I]f a particular color is inherently distinctive . . . it should be entitled to registration and enforcement.”).

135. See Oral Argument at 6-13, 25-26, 32-33 (colloquy on whether color can be inherently distinctive).

136. *Id.* at 12 (“weird color”); *id.* at 13 (“lime yellow”); *id.* at 27 (“lavender for ironing board covers”); *id.* at 32 (“hot neon pink”).

137. *Id.* at 10 (“[W]e are not attempting to appropriate color generally across the board to apply to every product that’s manufactured in this country. We are seeking, and we did obtain a registration from the Patent & Trademark Office for this green-gold color as applied in a limited area, to press pads only.”). As a practical matter, the limitation on the scope of Qualitex’s mark will be determined first, by application of the Trademark Office’s “related goods” test to others seeking to register the same color, and second, by application of tests of infringement such as the *Polaroid* factors. See *supra* part I.F.

sought in this hypothetical would be "the uniform blanketing of all of the product in a container of Planters peanuts with solid purple." A competitor could theoretically release noninfringing peanuts in which only one half of each nut was covered with purple. Alternatively, the competitor might be able to combine purple peanuts with peanuts of other colors without infringing Nabisco's mark.

The peanuts example demonstrates that whether a color will be considered inherently distinctive depends, at least in part, on how disjunctive is its use.<sup>138</sup> Purple is both an artificial and an unexpected color for nuts; therefore, its use on peanuts might readily trigger recognition in consumers that it is serving a source-identifying function. Purple on a particular item of clothing would not be disjunctive; consequently, consumers would have to learn of its source-identifying role through other channels—suggesting the appropriateness of requiring a showing of secondary meaning for protection in that instance, but not in the former.

E. *Meshing Qualitex with the Second Circuit Court of Appeals' Decision in Jeffrey Milstein, Inc. v. Gregor, Lawlor, Roth, Inc.*

In a post-*Qualitex* decision, *Jeffrey Milstein, Inc. v. Greger, Lawlor, Roth, Inc.*,<sup>139</sup> the Second Circuit Court of Appeals denied protection for a greeting card manufacturer's trade dress on grounds that it was a "concept" that lacked sufficient expression.<sup>140</sup> Analogizing to copyright law, the court explained: "[J]ust as copyright law does not protect ideas but only their concrete expression, neither does trade dress law protect an idea, a concept, or a gener-

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138. *Qualitex*, 115 S.Ct. at 1303 ("But over time, customers may come to treat a particular color on a product or its packaging (say, a color that in context seems unusual, such as pink on a firm's insulating material or red on the head of a industrial bolt) as signifying a brand.") (emphasis added); cf. *Mulberry Thai Silks, Inc. v. K & K Neckwear, Inc.*, 897 F. Supp. 789, 797 (S.D.N.Y. 1995) ("The plaintiff . . . has failed to prove that its particular use of bright colors and geometric patterns, in an industry in which the use of such design elements is common, is 'striking, unusual, or otherwise likely to differentiate the products of a particular producer.'" (emphasis added) (quoting *Mana Prods., Inc. v. Columbia Cosmetics Mfg. Corp.*, 65 F.3d 1063 (2d Cir. 1995))).

139. 58 F.3d 27 (2d Cir. 1995).

140. *Id.* at 32-33.

alized type of appearance.”<sup>141</sup> The court was concerned that conferring trademark protection on the “concept” of die-cut greeting cards would foreclose competitors from developing similar products.<sup>142</sup> The mark for which appellant sought protection consisted of “straight-on, strong photographic, glossy images of animals, persons or objects on die-cut cards that are cut without bleed of any kind.”<sup>143</sup>

On its face, this holding seems to conflict with the Supreme Court’s adoption in *Qualitex* of an extremely liberal construction of protection under the Lanham Act, and in particular the Court’s statement that “[i]t is the source-distinguishing ability of the mark . . . not its ontological status . . . that permits it to serve” the trademark function.<sup>144</sup> The Supreme Court explained:

The language of the Lanham Act describes [the universe of things that can qualify as a trademark] in the broadest of terms. It says that trademarks ‘includ[e] any word, name, symbol, or device, or any combination thereof.’ Since human beings might use as a ‘symbol’ or ‘device’ almost anything at all that is capable of carrying meaning, this language, read literally, is not restrictive.<sup>145</sup>

Under this liberal construction, appellant’s die-cut photograph scheme should have been characterized as a “device” under the Lanham Act.<sup>146</sup> The problem appellant’s mark posed was not one of ontological trademarkability but the more practical one of its capacity to be recognized as carrying source-identifying informa-

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141. *Id.* at 32.

142. *See id.* at 33 (describing the purpose of trade dress law as “to protect an owner of a dress in informing the public of the source of its products, without permitting the owner to exclude competition from functionally similar products”).

143. *Id.* (quoting Appellant’s Reply Brief at 6-7).

144. *Qualitex*, 115 S. Ct. at 1304.

145. *Id.* at 1302-03 (citation omitted); *see also supra* notes 21-25 and accompanying text.

146. The RANDOM HOUSE WEBSTER’S COLLEGE DICTIONARY, *supra* note 42, defines “device” broadly to include: “1. a thing made for a particular purpose, esp. a mechanical, electrical, or electronic invention or contrivance. 2. a plan, scheme, or procedure for effecting a purpose. . . . 5. something elaborately or fancifully designed.”



tion.<sup>147</sup>

Moreover, given the relative complexity of the appellant's mark in *Milstein* as compared to Qualitex's mark, how can Qualitex's green-gold, "pure and simple," be a candidate for protection when the *Milstein* appellant's cannot? Can *Milstein* be reconciled with *Qualitex*? More generally, can a proposed mark ever be too basic to receive protection?

In denying protection on the grounds of insufficient expressiveness, the Second Circuit Court of Appeals was apparently influenced by copyright law's insight that protection of overly basic expression can be anticompetitive.<sup>148</sup> Copyright law recognizes that protection of ideas and concepts may inhibit development of the very works that copyright law is designed to encourage.<sup>149</sup> A full discussion of copyright law is beyond the scope of this Article; what follows is a short summary of copyright doctrine commonly invoked to limit protection to expression that is not too basic.

First is the requirement that the copyrighted work be "minimal[ly]" creative, which is read into the statutory limitation on copyright protection to "original works of authorship."<sup>150</sup> In *Feist Publications, Inc. v. Rural Telephone Service Co.*,<sup>151</sup> the Supreme Court explained that "[o]riginal, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity."<sup>152</sup> The originality re-

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147. See *infra* notes 169-75 and accompanying text.

148. See generally 1 PAUL GOLDSTEIN, COPYRIGHT: PRINCIPLES, LAW AND PRACTICE §§ 1.2.2.2 to 1.2.2.4 (identifying limitations imposed on copyrightable subject matter which are designed to encourage creativity) (1984 & Supp. 1994); cf. Jay Dratler, *Distilling the Witches' Brew of Fair Use in Copyright Law*, 43 U. MIAMI L. REV. 233, 245-47 (1988) (discussing role of "fair use" doctrine in checking copyright's creativity-impeding impulses).

149. 1 GOLDSTEIN, *supra* note 148, at §§ 1.2.2.2. to 1.2.2.4.

150. 17 U.S.C. § 102(a) (1994).

151. 499 U.S. 340 (1991).

152. *Id.* at 345; see also *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102-03 (2d Cir. 1951) ("All that is needed to satisfy both the Constitution and the [copyright] statute is that the 'author' contributed something more than a 'merely trivial' variation. . . ."). Professor Goldstein notes that some judicially-imposed requirements—a

quirement is sometimes used by courts to deny copyright protection to very basic expression, including "fragmentary words or phrases."<sup>153</sup> However, given the low threshold of the originality and creativity requirements,<sup>154</sup> short slogans and the like may more properly be denied protection on grounds that they are insufficiently "expressive," as explained below.<sup>155</sup>

Second is the statutory exclusion from protection of "any idea, procedure, process, system, method of operation, concept, principle, or discovery."<sup>156</sup> Copyright distinguishes between the "idea" and the "expression," giving protection only to the latter.<sup>157</sup> Excluding ideas and concepts is necessary to effectuate copyright's purpose of promoting development of new works: "[i]n excluding protec-

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"novelty threshold, a quantitative threshold, and an expenditure of labor threshold"—"may contradict Congress' apparent intent to confine the originality standard to its traditionally low level—that copyrightable elements be original only in the sense that they are not copied from another source." 1 GOLDSTEIN, *supra* note 148, § 2.2.1, at 65 (citations omitted).

153. 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.01(B), at 2-16 (1994); *see, e.g.*, *Arica Inst., Inc. v. Palmer*, 970 F.2d 1067, 1075-76 (2d Cir. 1992) (sequence of one-word "ego fixations" held insufficiently creative); *Magic Mktg., Inc. v. Mailing Servs. of Pittsburgh, Inc.*, 634 F. Supp. 769, 771-72 (W.D. Pa. 1986) (envelopes bearing words "telegram," "gift check," and "priority message" held insufficiently creative).

154. 1 GOLDSTEIN, *supra* note 148, § 2.2.1, at 62.

155. *See, e.g.*, *Johnson v. Automotive Ventures, Inc.*, 890 F. Supp. 507, 511-12 (W.D. Va. 1995) (phrase "test market pricing" held insufficiently expressive to receive copyright protection). Professor Goldstein notes that the "originality" requirement and the "idea-expression" distinction are somewhat intertwined. 1 GOLDSTEIN, *supra* note 148, § 2.3, at 75 ("A basic plot device, two or three musical notes strung together or the combination of a few sketched lines will be unprotectible both because they are unexpressive and because it is likely that the author copied them from one of the many sources in which they have already appeared.") (citations omitted).

156. *See* 17 U.S.C. § 102(b) (1994) ("In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery. . .").

157. *Mazer v. Stein*, 347 U.S. 201, 217 (1954) ("[Under copyright law,] protection is given only to the expression of the idea—not the idea itself."); *Lotus Dev't Corp. v. Borland Int'l, Inc.*, 49 F.3d 807, 818 (1st Cir. 1995) ("[C]opyright assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by a work."), *aff'd*, — U.S. —, 1996 WL 12852 (U.S., Jan. 16, 1996) (No. 94-2003); *CCC Info. Servs. v. MacLean Hunter Mkt. Reports, Inc.*, 44 F.3d 61, 68 (2d Cir. 1994) (similar). *See generally* 1 GOLDSTEIN, *supra* note 148, at § 2.3.

tion for 'ideas,' [the copyright statute] adopts the longstanding rule that copyright does not attach to the building blocks of creative expression."<sup>158</sup> Such building blocks may include "[i]ndividual colors and shapes," since "to give one creator a monopoly over these basic elements would effectively stunt the efforts of other creators to elaborate on these elements in the production of their own works."<sup>159</sup> In addition, where the idea "merges" with the "expression", so that "the work's underlying idea can effectively be expressed in only one way," courts will withhold copyright protection.<sup>160</sup> Courts seeking to distinguish protectable expression from unprotectable ideas are required to engage in difficult, technical, and somewhat "ad hoc"<sup>161</sup> analysis of the actual elements that comprise a copyrighted work.

Third, copyright does not protect functional attributes of "useful articles,"<sup>162</sup> which are more properly protected under patent law.<sup>163</sup> Under the statute:

the design of a useful article . . . shall be considered a [protectable] pictorial, graphic, or sculptural work only if,

158. 1 GOLDSTEIN, *supra* note 148, § 2.3.1, at 78; *cf.* *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930) (describing a work of authorship in terms of increasing generalities: "there is a point in this series of abstractions where they are no longer protected, since otherwise the playwright could prevent the use of his 'ideas,' to which, apart from their expression, his property is never extended."), *cert. denied*, 282 U.S. 902 (1931).

159. 1 GOLDSTEIN, *supra* note 148, § 2.3.1, at 78-79 (citations omitted).

160. *See CCC Info. Servs.*, 44 F.3d at 68 ("[W]hen the expression is essential to the statement of the idea, the expression also will be unprotected, so as to insure free public access to the discussion of the idea."); *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1444 (9th Cir. 1994) ("[W]hen an idea and its expression are indistinguishable, or 'merged,' the expression will only be protected against nearly identical copying."), *cert. denied*, 115 S. Ct. 1176 (1995); *Kepner-Tregoe, Inc. v. Leadership Software, Inc.*, 12 F.3d 527, 533-34 (5th Cir. 1994) (similar). *See generally* 1 GOLDSTEIN, *supra* note 148, § 2.3.2, at 80.

161. *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960).

162. 17 U.S.C. § 101 (1994) ("useful article" defined as one "having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information").

163. 35 U.S.C. §§ 101-105 (1988 & Supp. V 1993); *see also* 35 U.S.C. §§ 171-173 (1988) (Design Patent Law).

and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.<sup>164</sup>

The courts generally require that such protectable elements be "physically" or "conceptually" separable from the useful article.<sup>165</sup>

As with trademarks, part of the impetus behind the lack of copyright protection for utilitarian features of works is to prevent manufacturers from using copyright law to extract monopolistic profits for unpatented goods.<sup>166</sup> Interestingly, as part of that analysis, basic shapes that are needed by competitors are sometimes interpreted as "utilitarian" and therefore nonprotectable.<sup>167</sup> Of course, something may be functional for copyright purposes and not for trademark purposes.<sup>168</sup>

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164. 17 U.S.C. § 101. The statute also defines "pictorial, graphic, and sculptural works," which are copyrightable subject matter under the statute, *id.* § 102(a)(5), to "include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned." *Id.* § 101.

165. See, e.g., *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1147 (2d Cir. 1987) (bike rack denied copyright protection since its "aesthetic elements cannot be said to be conceptually separable from [its] utilitarian elements"); *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411, 418-19 (2d Cir. 1985) (aesthetic features in mannequins for clothing display held not physically or conceptually separate from their use as utilitarian objects); *Esquire, Inc. v. Ringer*, 591 F.2d 796, 798-99 (D.C. Cir. 1978) (shape of lighting fixture not "capable of independent existence as a copyrightable pictorial, graphic, or sculptural work apart from the utilitarian aspect" (quoting the Register of Copyrights)), *cert. denied*, 440 U.S. 908 (1979); *Ted Arnold Ltd. v. Silvercraft Co.*, 259 F. Supp. 733 (S.D.N.Y. 1966) (simulation of antique telephone used as pencil sharpener casing held physically separable).

166. See 1 GOLDSTEIN, *supra* note 148, § 2.5.3, at 111 ("The purpose behind the Copyright Act's denial of protection to the utilitarian aspects of industrial design is to help protect consumers from paying more for unpatented utilitarian articles than the articles cost to produce and to market."); cf. 2 *id.* § 8.5 (describing anti-competitive effects of permitting copying of utilitarian works).

167. *Esquire*, 591 F.2d at 801 n.15 (quoting brief of the Register of Copyrights). Professor Goldstein notes, however, that the argument advanced in *Esquire* would be better resolved via operation of the merger doctrine, the "originality" requirement, and the "idea-expression" distinction, and advocates maintaining the integrity of these doctrines, by applying them precisely. 1 GOLDSTEIN, *supra* note 148, § 2.5.3.1(C), at 111.

168. See, e.g., *Brandir*, 834 F.2d 1142 (affirming district court holding that bike rack was not copyrightable since its utility was not separable from its aesthetic attributes, but

Returning to the realm of trademarks, trademark law, unlike copyright law, is not concerned with expressiveness per se. If the keystone of copyrightability is expressiveness, that of trademark is a mark's capacity to carry source-identifying information.<sup>169</sup> Anything capable of carrying source-identifying information should be able to serve as a trademark, absent other objections such as functionality.<sup>170</sup> Whether or not the mark is recognized by consumers as serving this source-identifying function is another problem altogether.<sup>171</sup>

It is true that a mark must be sufficiently expressive to carry source-identifying information.<sup>172</sup> Given this minimal requirement of expressiveness, conferring trademark protection on an elemental building block of expression—a concept or an idea—could, at least in theory, frustrate competitors' attempts to design their own marks.

In practice, it is very unlikely that protection of marks that are very basic would have such an anticompetitive effect. It is the author's suspicion that marks perceived as overly basic are in fact merely underdescribed.<sup>173</sup> The proper grounds for denying protection in such cases is not a theoretical objection to such marks but the fact that the mark's proponent has mischaracterized the mark

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reversing and remanding for redetermination of whether functionality precluded trademark protection).

169. See 2 MCCARTHY, *supra* note 24, § 2.01[1] ("In determining what can qualify as a trademark, it is crucial that the symbol in question be so distinctive that it is capable of performing the function of identifying and distinguishing the goods that bear the symbol."); see also text accompanying note 144 (quoting *Qualitex*).

170. See *supra* text accompanying notes 26-31.

171. See *supra* note 24 (defining "secondary meaning").

172. See *Mana Prods., Inc. v. Columbia Cosmetics Mfg., Inc.*, 858 F. Supp. 361, 366-67 (E.D.N.Y. 1994) ("The makeup compacts at issue in the present case . . . draw upon a *small, rudimentary vocabulary of forms* which, even in combination, do not speak audibly of the products' origin.") (emphasis added), *aff'd*, 65 F.3d 1063 (2d Cir. 1995). A mark, a slogan for example, may be sufficiently expressive to serve a source-identifying trademark function, but insufficiently expressive to merit copyright protection. See, e.g., *Official Airline Guides, Inc. v. Goss*, 6 F.3d 1385 (9th Cir. 1993) ("The Travel Planner").

173. See *supra* part III.A.2. See *Knitwaves, Inc. v. Lollytogs, Ltd.*, Nos. 94-7968, 94-9024, 1995 WL 673250, at \*10 (2d Cir. Nov. 13, 1995) (asserting that defendant had construed plaintiff's trade dress "too broadly" in arguing that conferring protection would be anticompetitive).

to which he or she has rights.<sup>174</sup> In the *Milstein* case, for example, it would have been helpful to know: (1) did appellant use exclusively color photos, black and white photos or a mixture of each? (2) were they of a consistent size? (3) was the paper used consistently of the same thickness and texture? etc. These are all points of variation on which a competitor could have seized in creating a potentially noninfringing line of cards.<sup>175</sup>

The fact that alternative designs exist does not mean that a mark deserves protection. In *Milstein*, the court also implicitly found that the mark for which protection was sought was "generic."<sup>176</sup> The term "generic" implies an incapacity to serve a source-identifying function.<sup>177</sup> The mark's inability to serve this function was a proper basis for denying protection, even as its ontological nature as an "idea" or "concept," in actuality a "device," was not.<sup>178</sup>

### CONCLUSION

All trademarks are composites of an infinite variety of design elements: some obvious to the senses, and some latent. At stake in *Qualitex Co. v. Jacobson Products Co.* was not whether color, in some disembodied form, is protectable under trademark law. Instead, the issue was whether a solid color of a designated hue,

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174. See *supra* part III.A.2.

175. See *supra* text accompanying notes 104-05.

176. See *Milstein*, 58 F.2d at 34.

177. See *supra* note 129.

178. The Second Circuit also affirmed the district court's determination that the "mark" lacked secondary meaning, holding in effect that, even if it were capable of carrying source-identifying meaning, the mark had failed to be perceived as doing so by the public. *Milstein*, 58 F.2d at 34. That result reflects a recurrent concern in trade dress cases: where the trade dress is the product configuration, the consumer will tend not to identify the attributes as serving a source-identifying function, but rather as simply presenting a pleasing design. See *Duraco Prods., Inc. v. Joy Plastic Enters.*, 40 F.3d 1431, 1440 (3d Cir. 1994) ("The difficulty is that . . . a product configuration differs fundamentally from a product's trademark, insofar as it is not a symbol according to which one can relate the signifier (the trademark, or perhaps the packaging) to the signified (the product)."); see also *Knitwaves, Inc. v. Lollytogs, Ltd.*, Nos. 94-7968, 94-9024, 1995 WL 673250, at \*11 (2d Cir. Nov. 13, 1995) (citing *Duraco* and DRAFT RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 16 cmt. b).

saturation and brightness, applied in a manner that conformed to the shape of a product, without variation in any of the previous elements, was protectable. Recognizing the richness and complexity of the Qualitex mark throws into relief the possible points of deviance available to competitors seeking to incorporate Qualitex's "green gold." The philosophical question of whether Qualitex's mark, and color marks in general, should be protected becomes an easy one, if properly construed: given the multiplicity of potentially noninfringing uses of Qualitex's color available to competitors, no reasonable basis exists for denying protection.

In failing to recognize the composite nature of Qualitex's mark, and, specifically, in apparently determining to protect exclusively the disembodied "green gold" hue, the Supreme Court violated the Anti-Dissection Rule. This Article has suggested that underdescription of marks—a tendency to leave out both latent and nonlatent elements of marks in describing the entirety of the mark to be protected—is systemic in trademark decisions. Underdescription violates the Anti-Dissection Rule, and it unnecessarily creates anticompetitiveness problems that work against protection of otherwise valid marks.

When confronting an infringement action involving a mark that appears to lack capacity to serve a trademark function, courts should look carefully to see if the mark has been truly described in its entirety. If the mark's proponent has underdescribed the mark's elements, perhaps in an attempt to get broader protection than it deserves, then *that* should be the basis for denying protection. Only if the mark truly is incapable of serving a trademark function, because it is generic or because needed public awareness of its source-carrying functions has not developed, is an unqualified denial of protection appropriate.

Recognizing a greater degree of complexity in a mark should not translate into greater protection. In an infringement action involving two marks, the outcome turns on whether the marks' overall impressions are confusing. Latent elements, by definition those elements of which the perceiver of the marks is less sensitive or perhaps even unconscious, are unlikely to make the difference in a finding of confusion or nonconfusion.

Nonetheless, recognition of latent elements may have a practical effect in infringement actions. It may assist the mark-holder in rebutting a defendant's claim that its mark is invalid on anticompetitiveness or other grounds. The courts may sometimes too easily deny protection without even reaching the issue of confusion as to source, on the grounds that protecting plaintiff's mark will confer an unreasonable disadvantage on competitors. Many of those competitors may be hypothetical, and most may not even be before the court. Thus, considering the mark's latent elements may enable a plaintiff to prosecute its action, even if it will not guarantee plaintiff's victory on the infringement issues.

The ultimate consequence of adopting what is, in effect, a more liberal approach to protectability would be to relieve pressure on courts to engage in abstract analysis at the outset of the case. Correlatively, it would put more emphasis on the substantive issues: whether the plaintiff has demonstrated secondary meaning, in the event that his or her mark is not inherently distinctive; and whether infringement exists. Given our jurisprudential and constitutional mandate to litigate concrete rather than hypothetical disputes, to adjudicate "cases and controversies," is that not a worthy result?